BOURNS, INC. and Marlan E. Bourns,
Plaintiffs-Appellants and Cross Appellees,

v.

ALLEN-BRADLEY COMPANY et al.,
Defendants-Appellees and Cross-Appellants.
Nos. 72-1222, 72-1223.

United States Court of Appeals,
Seventh Circuit.

Argued April 5, 1973.

Decided June 14, 1973.

Rehearing En Banc Denied July 17, 1973.

Before CLARK, Associate Justice,* and PELL and SPRECHER, Circuit Judges.

CLARK, Associate Justice.

Appellants Bourns, Inc. and Marlan E. Bourns challenge the District Court's application of the doctrine of collateral estoppel as applied in Blonder-Tongue Laboratories, Inc. v. University of Illinois Foundation, 402 U.S. 313, 91 S.Ct. 1434, 28 L.Ed.2d 788 (1971), to bar this patent infringement suit which was filed in the United States District Court for the Northern District of Illinois against Allen-Bradley Company et al., appellees. Appellants alleged infringement of their "leadscrew actuated potentiometer," Patent No. 2,777,926 (the '926 patent). Among the defenses appellees pleaded collateral estoppel based on the final judgment entered against appellants in Bourns, Inc. v. Dale Electronics Inc., 308 F.Supp. 501 (D.Neb. 1969). After the Supreme Court handed down the *Blonder-Tongue* decision, appellees filed amended answers further alleging that

* Associate Justice Tom C. Clark, United States Supreme Court, Retired, is sitting by designation.

appellants had voluntarily dismissed their appeal to the United States Court of Appeals for the Eighth Circuit on May 4, 1970, and moved for summary judgment. The District Court, 348 F.Supp. 554, granted appellees' motion, holding that *Blonder-Tongue* governed this case and that the *Dale* decision had invalidated all claims embraced in the '926 patent. We agree that *Blonder-Tongue* bars appellants from relitigating the patent claims explicitly invalidated in *Dale,* but reverse the judgment below insofar as it bars appellant from relitigating the remaining '926 claims.

1. *The Dale Judgment.*

In the *Dale* pleadings Bourns had alleged infringement on the basis of its patent generally, *i. e.,* without singling out specific claims. Likewise, the defendants in *Dale* had counterclaimed for a declaration that the entire patent was invalid. However, the *Dale* judgment stated in relevant part:

> "2. Claims 1, 2, 11, 14, 15, 16 and 20 of the United States Patent No. 2,777,926 are invalid * * * *
>
> 7. The Amended Complaint is dismissed with prejudice, and the Amended Counterclaim is sustained to the extent indicated."

The District Court here found the *Dale* judgment ambiguous in its application to the '926 claims not explicitly mentioned therein. On the basis of several isolated statements in the *Dale* opinion (*e. g.,* ". . . the '926 patent is held to be invalid.") it concluded that the *Dale* court intended to hold the entire patent invalid.

We disagree with the District Court's interpretation and conclude that *Dale* is binding only as to the claims specifically mentioned in its judgment. The opinion in that case begins: "Plaintiff relies upon claims 1, 2, 11, 14, 15, 16 and

20 of the '926 patent." Further down in the opening paragraph the opinion continues: "In determining the validity of the patent this Court must ascertain the essence and scope of the patent *as stated in the above-mentioned claims.*" (Emphasis added.) Still further in the opinion the court says: "Commencing with the history and progress of this application through the patent office as finally embodied in claims 1, 2, 11, 14, 15, 16 and 20, it provides some insight into the scope of the patent." And in the judgment the *Dale* court again sets out these claims as invalid. We think it clear from these references that where the court referred to the '926 patent as being invalid, it was referring only to those claims specifically designated at the outset and re-stated in the final judgment. As Professor Moore teaches:

> [A prior judgment] operates as a collateral estoppel as to, but only as to, those matters or points which were in issue or contraverted *and upon the determination of which the initial judgment necessarily depended.* [Emphasis added.]

1B Moore's Federal Practice 3777 (2d ed. 1965); and, as Judge Learned Hand explained almost forty years before, "... [collateral] estoppel extends only to facts decided and necessary to the decision." Irving Nat. Bank v. Law, 10 F.2d 721, 724 (2 Cir. 1926). Since the *Dale* court's judgment by its terms did not depend on the invalidity of claims not specified in that judgment, appellants are not collaterally estopped from asserting the remaining claims of the '926 patent.

2. *Application of the Blonder-Tongue Collateral Estoppel Doctrine.*

Appellants also urge that collateral estoppel should not be applied to bar their raising the same patent claims that

were declared invalid in *Dale*. They rely on the statement in *Blonder-Tongue* that "the patentee-plaintiff must be permitted to demonstrate, if he can, that he did not have 'a fair opportunity procedurally, substantively and evidentially to pursue his claim the first time.'" 402 U.S. at 333, 91 S.Ct. at 1445. Appellants argue that they lacked an incentive to fully litigate in *Dale* due to (1) an alleged anti-patent bias of the Eighth Circuit, (2) the relative insignificance of the *Dale* suit, (3) new procedural advantages made available since *Dale* was begun, (4) the alleged greater hospitality of the Seventh Circuit toward patents, and (5) their reliance on the pre-*Blonder-Tongue* case of Triplett v. Lowell, 297 U.S. 638, 56 S.Ct. 645, 80 L.Ed. 949 (1936), which required mutuality of estoppel. We need not pause to discuss these claims. They are fully answered by the District Court, which correctly noted that appellants themselves chose the Nebraska forum; that the *Dale* court applied Supreme Court standards of patent validity as enunciated in Graham v. John Deere Co., 383 U.S. 1, 86 S.Ct. 684, 15 L.Ed.2d 545 (1966); that the *Dale* litigation involved a potential recovery by appellants of approximately $1,000,000, and that "most if not all" of the evidence alleged by appellants to have been newly discovered was in existence and discoverable during the *Dale* litigation. The District Court concluded that appellants lost in *Dale* after a full and fair hearing and that the equities fully justify the application of collateral estoppel against them.

The District Court also concluded that the Supreme Court in *Blonder-Tongue* implicitly rejected reliance on its prior decision in Triplett v. Lowell, *supra,* as an adequate basis for avoiding the general rule fashioned in the later decision. *See* Monsanto Co. v. Dawson, Chemical Co., 443 F.2d 1035 (5 Cir. 1971), cert. denied 405 U.S. 974, 92 S.Ct. 1191, 31 L.Ed.2d 248 (1972). We agree. The *Dale* litigation was pending for seven years in a jurisdiction with no back-

log; the trial itself lasted six days and produced a transcript of 610 pages; and the potential recovery was over $1,000,000. Thus, appellants had ample incentive to litigate the case to the end. True, the Supreme Court held in *Triplett* that collateral estoppel did not preclude "relitigation of the validity of a patent claim previously held invalid in a suit against a different defendant." Triplett v. Lowell, *supra,* at 644 of 297 U.S., 56 S.Ct. 645. However, in overruling *Triplett,* the *Blonder-Tongue* Court did not see fit to rule prospectively, though it has so limited recent rulings in other contexts where retrospective application would work hardship and inequity. Phoenix v. Kolodziejski, 399 U.S. 204, 213-215, 90 S.Ct. 1990, 26 L.Ed.2d 523 (1970); Cipriano v. City of Houma, 395 U.S. 701, 706, 89 S.Ct. 1897, 23 L.Ed.2d 647 (1969). Indeed, it specifically commented that in the end the use of the collateral estoppel doctrine "will necessarily rest on the trial courts' sense of justice and equity." 402 U.S. at 334, 91 S.Ct. at 1445. The District Court has carefully appraised the justice and equity of applying the doctrine here and has held against appellants. We have examined the record and conclude that its findings are fully supported therein.

Appellants dispute that they had full and fair judicial resolution of their claims. They suggest that they abandoned the *Dale* appeal in reliance on the *Triplett* rule. It may be that in some situations reliance on *Triplett* should relieve a patentee from the consequences of the *Blonder-Tongue* decision's new collateral estoppel rules. But the circumstances surrounding the *Dale* litigation, particularly the large potential recovery and the time and effort already expended, convince us that appellants would have pursued their appeal regardless of the *Triplett* rule had they held any reasonable expectation of ultimate success. Since appellants abandoned their appeal because they saw no reasonable chance of prevailing *on the merits,* we believe it

equitable both as a general matter and specifically under the *Blonder-Tongue* decision to apply the estoppel rule established in that decision.

The judgment below is reversed insofar as it bars appellants from asserting the patent claims other than those explicitly declared invalid in the *Dale* judgment. In other respects the judgment is affirmed.

PELL, Circuit Judge (concurring in part and dissenting in part).

I concur in the majority opinion insofar as it reverses that part of the judgment of the district court which barred appellants from asserting patent claims other than those explicitly declared invalid in the *Dale* judgment. However, I respectfully dissent from the balance of the majority opinion.

In considering the contentions of the appellants that the judgment in the District Court of Nebraska does not collaterally estop them as to any claims of the patent asserted in the Northern District of Illinois, the following significant chronology should be kept in mind.

The decision in the *Dale* case, Bourns, Inc. v. Dale Electronics Incorporated, 308 F.Supp. 501 (D.Neb.1969), was handed down on December 29, 1969. The original decision of this court in University of Illinois Foundation v. Blonder-Tongue Laboratories, Inc., 422 F.2d 769 (7th Cir. 1970), was issued on February 13, 1970, and was modified on denial of rehearing on April 2, 1970.

The appellants dismissed their appeal from the *Dale* district court decision in the Eighth Circuit on May 4, 1970. The complaint which was the fountainhead of the present appeal was filed in the Northern District of Illinois on August 11, 1970.

The opinion in the *Blonder-Tongue* case in the United States Supreme Court, Blonder-Tongue Laboratories, Inc. v. University of Illinois Foundation, 102 U.S. 313, 91 S.Ct. 1434, 28 L.Ed.2d 788, was handed down on May 3, 1971.

The Supreme Court in *Blonder-Tongue* overruled a precedent which had been on the books since 1936, Triplett v. Lowell, 297 U.S. 638, 56 S.Ct. 645, 80 L. Ed. 949 (1936). *Triplett* indicated that "the rules of the common law applicable to successive litigations concerning the same subject-matter" did not preclude "relitigation of the validity of a patent claim previously held invalid in a suit against a different defendant." 297 U.S. at 644, 56 S.Ct. at 648. This court in its original *Blonder-Tongue* opinion, while observing that it would seem sound judicial policy that the adjudication of a patent validity issue against the plaintiff in one action where it was a party would provide a defense in any other action by the plaintiff for infringement of the same patent, nevertheless stated, "That, however, is not the law in this field." 422 F.2d at 772.

In essence, the majority opinion in the present appeal concludes that the district court carefully appraised the justice and equity of applying the *Blonder-Tongue* doctrine to the present case and upon so doing reached a correct result. I cannot agree with the initial premise for, as I read the district court's opinion, it concluded that the "justice in this matter is pre-empted by the *Blonder-Tongue* decision itself," and plaintiffs' reliance on pre-*Blonder-Tongue* decisions when abandoning their appeal "is contrary to the holding of that controlling decision which abrogated the prior law."

I do not read the controlling case so broadly. I note the following significant passages in the opinion of the Court. "The broader question is whether it is any longer tenable to afford a litigant more than one *full and fair opportunity*

for judicial resolution of the same issue." 402 U.S. at 328, 91 S.Ct. at 1442. "But the case before us involves neither *due process* nor 'offensive use' questions. Rather, it depends on the considerations weighing for and against permitting a patent holder to sue on his patent after it has once been held invalid following *opportunity for full and fair trial.*" 402 U.S. at 330, 91 S.Ct. at 1443. "Presumably he [the patentee] was prepared to litigate and to litigate to the finish against the defendant there involved." 402 U.S. at 332, 91 S.Ct. at 1444. "Rather, the patentee-plaintiff must be permitted to demonstrate, if he can, that he did not have *'a fair opportunity procedurally, substantively and evidentially* to pursue his claim the first time.' . . . This element in the estoppel decision will comprehend, we believe, the important concerns about the complexity of patent litigation and the posited hazard that the prior proceedings were seriously defective." 402 U.S. at 333, 91 S.Ct. at 1445. "'[T]he expense of defending a patent suit is often staggering to the small businessman.'" 402 U.S. at 334, 91 S.Ct. at 1445. (Emphases added.)

With further reference to the matter of expense if the *Triplett* rule were maintained, the Court observed the money expended in subsequent litigation could be put to better use, such as further research and development, and that subsequent defendants might determine it was preferable to pay royalties under a license rather than to incur the costs of litigation. 402 U.S. at 338, 91 S.Ct. 1434.

The Court also adverted to the fact that there would be some saving of judicial time "if even a few relatively lengthy patent suits may be fairly disposed of on pleas of estoppel." 402 U.S. at 348, 91 S.Ct. at 1453.

Finally, the Court, since the issue had not been ventilated below, remanded the cause so that, *inter alia,* the patentee

could have the opportunity to demonstrate "why an estoppel should not be imposed in this case."

In sum, the Court in *Blonder-Tongue* did not, as the district court seems to have done, lay down a hard and fast rule.

Assuming *arguendo* that the Supreme Court intended the sweep of *Blonder-Tongue* to be sufficiently broad to encompass all litigation the purpose of which was to relitigate a patent issue which had already elsewhere been found wanting, irrespective of whether that litigation was intiated before or after the change of the law, then applying the rationale which produced *Blonder-Tongue,* as specifically referred to hereinbefore, in my opinion the plaintiffs should not be estopped in the present case. Obviously, of course, they might well have been estopped if the litigation had been started after the rendition of *Blonder-Tongue,* but that is not the posture of this case.

Theoretically, the plaintiffs had an opportunity for a full and fair judicial resolution of the issue in *Dale.* Certainly they had the opportunity for a *full* resolution. All they had to do to continue expending the not inconsiderable money which would necessarily have been involved in briefing and arguing in the Eighth Circuit and then pursuing certiorari in the Supreme Court. They did not choose to do so for reasons which I find persuasive and which are outlined in the majority opinion. Pursuing the litigation, of course, would also have put Dale to considerable expense. The plaintiffs were not prepared to litigate to the finish against the defendant there involved for the reasons indicated. Nor is the cost rationale of *Blonder-Tongue* brought into full play here. This is no case of a small businessman being forced willy-nilly into a licensing agreement. The very names of the corporate defendants would indicate otherwise; in addition, the action below was brought as a class

action, presumably with the intent of putting an end one way or the other to the validity of the claims. Plaintiffs by their dismissal and their filing of the broad-breadth subsequent action were travelling economy class, as to themselves, the judiciary of the Eighth Circuit, Dale, and, to some extent, their individual prospective infringer-opponents.

While the plaintiffs had the full opportunity adverted to in *Blonder-Tongue,* it seems clear to me that we are not able to say with certainty that the second prong of fairness was equally present. It is obvious that new counsel who came onto the scene subsequent to the district court decision in *Dale* did not think so. The decision to dismiss the appeal and to file elsewhere against the remaining alleged infringers was made in the forepart of the year 1970 apparently about the time that this court decided that it did not agree with the result which had been reached on the patent involved in *Blonder-Tongue* by a district court in the Eighth Circuit.

The decision was made during the same period of time and the same patent litigation climatic conditions which compelled the chief judge of a district court in the Eighth Circuit to observe in Woodstream Corp. v. Herter's, Inc., 312 F.Supp. 369, 370 (D.Minn.1970), modified, 446 F.2d 1142 (8th Cir. 1971), as follows:

> "The courtrooms within the province of the Eighth Circuit Court of Appeals do not afford a congenial forum to the holder of a United States patent. A reading of the decided cases clearly reflects this. It is especially true since 1966 following the Supreme Court's expressions in Graham v. John Deere Co., 383 U.S. 1, 86 S.Ct. 684, 15 L.Ed.2d 545. I can find no record of the Eighth Circuit Court ofAppeals, upholding the validity of a patent since *Graham.* It did so sparingly before *Graham.*"

It may well be that all of the patent cases which happened to have been filed in the Eighth Circuit during the preceding decade were of a questionable variety and on that phase of the matter I do not comment. I do note, however, "the batting average" which competent counsel, relying on *Triplett,* must have taken into consideration. The same counsel could not have been unaware of the more favorable climate in the Seventh Circuit. See the discussion of the situation in the two circuits by this court in Scam Instrument Corp. v. Control Data Corp., 458 F.2d 885, 888 n.4 (7th Cir. 1972), in which it is indicated that the Eighth Circuit did sustain the validity in part of a patent in 1971. This, however, was subsequent to *Blonder-Tongue.*

While the foregoing discussion was based on the *arguendo* assumption that *Blonder-Tongue* is retrospective, I do not think that it was so intended, nor that the Supreme Court would reach the result that it is. The district court in the present case, however, had no doubt, observing that the "Supreme Court could have softened the blow by ruling only prospectively in *Blonder-Tongue,* as it has done on several occasions." If the district court merely meant that the Supreme Court in handing down *Blonder-Tongue* could have specified that it was prospective only, I, of course, would have to agree. In so doing, however, I would also note that the Court did not specify that the change of the law was retrospective either. The issue simply was not reached, and I am at a loss for the basis of the confidence of expression of the district court that the decision was retrospective. If the district court meant that because collateral estoppel could be considered as a defense to the plaintiff's suit in *Blonder-Tongue* it must be always retrospective, which seemed to be a theory advanced by the defendants in oral argument, then I must certainly disagree with the result put forward by the district court. When new law is established or, more importantly, when existing law is

changed, it always is retrospective as to the particular litigant who is unsuccessful. This is inherent, for courts do not customarily give advisory opinions. This is a far cry though from inferring that the decision is retrospective as to other litigants who were relying on the pre-existing law.

The tests for determining whether a "new" decision should be applied retrospectively have been the subject of judicial attention. Chief Justice Burger had occasion to advert to this facet of the law in Lemon v. Kurtzman, —— U.S. ——, 93 S.Ct. 1463, 1467, 36 L.Ed.2d 151 (1973) in which it was stated:

> "Claims that a particular holding of the Court should be applied retroactively have been pressed on us frequently in recent years. Most often, we have been called upon to decide whether a decision defining new constitutional rights of a defendant in a criminal case should be applied to convictions of others that predated the new constitutional development. *E. g.*, Robinson v. Neil, 409 U.S. 876 [93 S.Ct. 876, 35 L.Ed.2d 29] (1973); Adams v. Illinois, 405 U.S. 278 [92 S.Ct. 916, 31 L.Ed.2d 202] (1972); Desist v. United States, 394 U.S. 244 [89 S.Ct. 1030, 22 L.Ed.2d 248] (1969); Stovall v. Denno, 388 U.S. 293 [87 S.Ct. 1967, 18 L.Ed.2d 1199] (1967); Johnson v. New Jersey, 384 U.S. 719 [86 S.Ct. 1772, 16 L.Ed.2d 882] (1966); Tehan v. Shott, 382 U.S. 406 [86 S.Ct. 459, 15 L.Ed.2d 453] (1966); Linkletter v. Walker, 381 U.S. 618 [85 S.Ct. 1731, 14 L.Ed.2d 601] (1965). But 'in the last few decades, we have recognized the doctrine of non-retroactivity outside the criminal area many times, in both constitutional and nonconstitutional cases.' Chevron Oil Co. v. Huson, 404 U.S. 97, 106 [92 S.Ct., 349, 355, 30 L.Ed.2d 296] (1971); Hanover Shoe v. United Shoe Machinery Corp., 392 U.S. 481 [88 S.Ct. 2224, 20 L.Ed.2d 1231] (1968); Simpson v. Union Oil Co., 377 U.S. 13 [84 S.Ct. 1051, 12 L.Ed.2d 98] (1964); England v. State Board of Medical Examiners, 375 U.S. 411 (84 S.Ct. 461, 11 L.Ed.2d 440] (1964). We have approved nonretro-

active relief in civil litigation, relating, for example, to the validity of municipal financing founded upon electoral procedures later declared unconstitutional, Cipriano v. City of Houma, 395 U.S. 701, [89 S.Ct. 1897, 23 L.Ed.2d 647] (1969), and City of Phoenix, Arizona v. Kolodziejski, 399 U.S. 204 [90 S.Ct. 1990, 26 L.Ed.2d 523] (1970); or to the validity of elections for local officials held under possibly discriminatory voting laws, Allen v. State Board of Elections, 393 U.S. 544 [89 S.Ct. 817, 22 L.Ed.2d 1] (1969). In each of these cases, the common request is that we reach back to disturb or to attach legal consequence to patterns of conduct premised either on unlawful statutes or on a different understanding of the controlling judge-made law than the rule that ultimately prevails."

Tests for determining retroactivity are set forth in Chevron Oil Co. v. Huson, 404 U.S. 97, 106-107, 92 S.Ct. 349, 355, 30 L.Ed.2d 296 (1971), as follows:

"In our cases dealing with the non-retroactivity question, we have generally considered three separate factors. First, the decision to be applied non-retroactively must establish a new principle of law, either by overruling clear past precedent on which litigants may have relied, see, *e.g.*, Hanover Shoe v. United Shoe Machinery Corp., *supra*, 393 U.S. at 496 [88 S.Ct., at 2233], or by deciding an issue of first impression whose resolution was not clearly foreshadowed, see, *e.g.*, Allen v. State Board of Elections, *supra*, 393 U.S. at 572 [89 S.Ct., at 835]. Second, it has been stressed that '[w]e must . . . weigh the merits and demerits in each case by looking to the prior history of the rule in question, its purpose and effect, and whether retrospective operation will further or retard its operation.' Linkletter v. Walker, *supra*, 381 U.S. at 629 [85 S.Ct., at 1738]. Finally, we have weighed the inequity imposed by retroactive application, for '[w]here a decision of this Court could produce substantial inequitable results if applied retroactively, there is ample basis in our cases for avoiding the "injustice or hardship" by a holding

of nonretroactivity.' Cipriano v. City of Houma, *supra*, 395 U.S. at 706 [89 S.Ct. at 1900].

In an analogous situation this court recently considered the question in Bendix Corporation v. Balax, Inc., 471 F.2d 149 (7th Cir. 1972), and concluded that the holding in Lear, Inc. v. Adkins, 395 U.S. 653 (1969), should not be applied retroactively. *Bendix* has particular significance here because in *Lear* the Court held that a licensee is not estopped to interpose the invalidity of the licensed patent as a defense to an action by the patentee-licensor to enforce the license agreement. The Court expressly overruled its 1950 holding to the contrary. The venerability of *Triplett* was fourteen years greater.

Applying the tests of *Chevron* to the present case: (a) a new principle of law was established by overruling clear past precedent on which litigants not only may but did in fact rely; (b) since litigants who have instituted lawsuits in reliance upon *Triplett* prior *to Blonder-Tongue* must of necessity be relatively limited in numbers, retrospective application would scarcely seem to further the operation of the principle enunciated; and (c) there is an inherent inequitable result if the principle is applied retroactively with injustice being avoided by a holding of nonretroactivity.

It is to be noted that the *Chevron* test refers to a foreshadowing of the result but does so only in relation to the decision of a case of first impression. If "writing on the wall" is operative in the situation of a change of law also, then, although the *Triplett* rule may have been questioned by decisions and commentators, I am unaware of any clear-cut indication from the Supreme Court on which a lawyer could advise his client to the effect that *Triplett* would be overruled. "Rumblings," as the district court referred to foreshadowing, is a chimerical basis for advice to a com-

mercial client who in the conduct of his affairs requires predictabliity of as great certitude as possible if he is not to be exposed to unexpected and undesired expensive litigation.

As to foreshadowing, the situation was analogous in *Lear*, upon which Judge Sprecher commented in *Bendix*, 471 F.2d at 156, as follows:

> "In *Lear*, there was an express overruling of a past precedent. Although the Court noted that '[l]ong before *Hazeltine* was decided, the estoppel doctrine had been so eroded that it could no longer be considered the "general rule"' (395 U.S. at 664, 89 S.Ct. at 1908), nevertheless in *Hazeltine* the Court characterized it as the general rule. Whether *Hazeltine* was 'clear past precedent' to the Supreme Court in 1971, the unqualified pronouncement in that case undoubtedly made the doctrine clear enough to parties relying upon it from 1950 to 1971." [Footnote omitted.]

If foreshadowing is pertinent in the change of law situation, then it would appear to me that the present case presents a stronger basis for finding no clear and compelling presaging of the change than in the *Lear* situation, where there had already been substantial erosion of the set-aside doctrine in 1950 at the time the rule was recognized as the general rule, although it was not actually set aside for another 19 years.

I have adverted to the matter of advice of counsel in the commercial field and, in ultimate analysis, I find that the most persuasive reason for not denying the plaintiffs here their full day in court. The reasons are more compelling than the ordinary deference to precedent stated by Justice Cardozo, "Adherence to precedent must . . . be the rule rather than the exception if litigants are to have faith in the even-handed administration of justice in the courts."[1]

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[1] The Nature of the Judicial Process 34 (1921).

The essentiality of definite predictability was recognized by Mr. Justice Frankfurter in his separte opinion in Monroe v. Pape, 365 U.S. 167, 221–222, 81 S.Ct. 473, 503, 5 L.Ed.2d 492 (1961), when, speaking of the civil rights case before the Court, he observed, "This is not an area of commercial law in which, presumably, individuals may have arranged their affairs in reliance on the expected stability of decision." Here the plaintiffs did arrange their affairs on what counsel justifiably could have taken as well-established law, and they should not now suffer because of a subsequent change of that law.

The principle of continuance of adherence to precedent was overridden in its significance by policy factors deemed of greater importance in *Blonder-Tongue*. The resultant change of law, however, in my opinion, should not be controlling on the relatively narrow issue here involved in the situation of commitments made in reliance upon the prior law, which commitments were made prior to the change in the law.

BOURNS, INC., and Marlan E. Bourns,
Plaintiffs,

v.

ALLEN-BRADLEY COMPANY et al.,
Defendants.
No. 70 C 1992.

United States District Court,
N. D. Illinois, E. D.
Feb. 2, 1972.

DECISION and ORDER

McMILLEN, District Judge.

This cause comes on to be heard on motion of the defendants for summary judgment on the ground of collateral estoppel under Blonder-Tongue Laboratories, Inc. v. University of Illinois Foundation, 402 U.S. 313, 91 S.Ct. 1434, 28 L.Ed.2d 788 (May 3, 1971). The court concludes that the defendants' Motion should be granted, with the result that a final judgment will be entered in their favor. The earlier motions filed by the defendants are thereby rendered obsolete.

The Complaint in the case at bar was filed on August 11, 1970 by the owner and assignee of United States Patent No. 2,777,926 issued on January 19, 1957. Plaintiffs allege that six corporate defendants, as representatives of a class, had been infringing their patent for six years and would continue to do so unless enjoined. Defendants answered separately and alleged that the patent was invalid for obviousness and for other reasons. They also alleged that plaintiffs were estopped and barred from the instant action by virtue of a final judgment entered against them by the United States District Court for Nebraska in Bourns, Inc. v. Dale Electronics Inc., 308 F.Supp. 501 (D.Neb.1969).

After the decision in *Blonder-Tongue, supra,* defendants filed amended answers in which they alleged further that plaintiffs had acquiesced in the Nebraska judgment by voluntarily dismissing their appeal to the United States Court of Appeals for the Eighth Circuit on May 4, 1970. Defendants thereupon filed the instant motions for summary judgment which in substance are motions for judgment on the pleadings under F.R.Civ.P. 12(c).

The only question on such a motion is whether a genuine issue of material fact remains to be decided and, if not, whether the moving parties are entitled to judgment as a matter of law. Since plaintiffs did not move to strike or to file a reply to defendants' affirmative defenses of estoppel and *res judicata,* the pleadings do not spell out plaintiffs' position with respect to these defenses. The court has considered the contentions made in plaintiffs' brief, however, in light of the defenses suggested by the Supreme Court's decision in its unanimous *Blonder-Tongue* decision.

Despite possible harshness on occasion, there can be no doubt that *Blonder-Tongue* applies retrospectively. Monsanto Co. v. Dawson Chemical Co., 443 F.2d 1035 (5th Cir. 1971), petition for cert. filed, No. 71-787, 40 U.S.L.W. 3356. It is true that plaintiffs were not apprised of this particular decision when they abandoned their appeal to the Eighth Circuit, but there were rumblings of it (cf. 402 U.S. 313, 91 S.Ct. at p. 1453). The same unfortunate turn of events occurred in *Blonder-Tongue* when the University of Illinois Foundation unexpectedly became bound by an adverse decision of the Eighth Circuit in University of Illinois Foundation v. Winegard Co., 402 F.2d 125 (8 Cir. 1968), cert. den. 394 U.S. 917, 89 S.Ct. 1191, 22 L.Ed.2d 452 (1969). The Supreme Court could have softened the blow by ruling only prospectively in *Blonder-Tongue,* as it has done on several occasions. Cf. England v. Louisiana State Bd. of

Med. Exam., 375 U.S. 411, 84 S.Ct. 461, 11 L.Ed.2d 440 (1964). But the court no doubt felt that the public policy which it was enunciating in *Blonder-Tongue* was sufficient to justify an all-embracing decision.

Plaintiffs argue that the adverse decision by the federal court in Nebraska did not affect the entire patent but only certain of its claims. This argument is based primarily on that court's judgment order, entered after the decision reported at 308 F.Supp. 501, which reads in part: "Claims 1, 2, 11, 14, 15, 16 and 20 of United States Patent No. 2,777,926 are invalid." The court then dismissed the Amended Complaint "with prejudice" and sustained the Amended Counterclaim "to the extent indicated." The record in that case does not reveal whether the parties thereafter treated the patent as invalid, but the court's published opinion makes clear that it found the entire patent invalid. Among other things, the court's decision says with respect to Patent No. 2,777,926: ". . . the '926 patent is held to be invalid." 308 F.Supp. at 507.

The pleadings in the Nebraska suit demonstrate that both the plaintiffs and the defendant were litigating the validity of the patent, not merely part of it. The Amended Complaint alleged that the patent was "duly and regularly issued" to the plaintiffs and that the defendant had been infringing it for six years. Plaintiffs sought an injunction, damages and attorneys fees "pursuant to the patent laws of the United States." Defendant in its Amended Answer denied knowledge of whether the patent was duly and regularly issued and stated "Plaintiffs are left to their proofs." Defendant also pleaded affirmative defenses and filed a counterclaim for declaratory judgment in which it alleged that the patent was invalid by reason of anticipation, obviousness, and other grounds going to the entire patent. Nowhere in the pleadings are specific claims or partial invalidity alleged.

In the case at bar the Complaint and Answers likewise go to the validity of the entire patent, and no mention is made of specific claims. Plaintiffs now contend that they are relying herein on Claims Nos. 3, 4, 6, 7, 12, 19, 21 and 22, as well as the ones itemized by the Nebraska judgment order. Plaintiffs' specification in the case at bar arises from their answers to interrogatories when the defendants inquired as to specific claims which their particular devices were allegedly infringing. Plaintiffs answered by listing most, if not all, of the 22 claims in their patent (Supplemental Answer filed July 20, 1971), but they have never amended their complaint to allege that they were relying on the validity of those claims not specified by the Nebraska court. We conclude that the Nebraska judgment order is explained by the same procedures as explains this particular defense raised by the plaintiffs: the court was referring to the claims alleged to be infringed by a defendant's product but had no intention of changing its decision of invalidity. *Blonder-Tongue* precludes us from relitigating this decision.

Even if *Blonder-Tongue* is potentially a bar to the entire complaint (as this court holds), plaintiffs seek to avail themselves of the exceptions left open to them by the Supreme Court's decision. Plaintiffs argue that the Nebraska court failed to grasp the issues of the controversy and in particular misapplied Graham v. John Deere Co., 383 U.S. 1, 86 S.Ct. 684, 15 L.Ed.2d 545 (1966). The Supreme Court cited this case as one example where a trial court might have completely failed to meet and decide the issues before it, therefore aborting estoppel. From an examination of the Nebraska court's decision, however, it not only appears that the court cited and purported to follow Graham v. John Deere Co. (which is all the Supreme Court suggested it do), but also that the trial court did

grasp the issues and render a full and fair opinion on the merits. Any revision of that decision lay there or in the Court of Appeals, not here.

Plaintiffs next argue that they lacked the requisite incentive to litigate to a finish in the Nebraska suit. They blame this partly on the allegedly myopic view of patents taken by the Eighth Circuit Court of Appeals as compared with the enlightened view of the Seventh Circuit. This court need not enter that debate because the Supreme Court itself discounts the argument: choice of forum militates against the plaintiffs who made the choice, albeit without realization that they would be universally bound by the result. As to plaintiffs' alleged reliance on pre-*Blonder-Tongue* decisions when abandoning their appeal, that argument is contrary to the holding of that controlling decision which abrogated the prior law.

The subsequent proceedings in the *Blonder-Tongue* litigation are instructive, as reported in the University of Illinois Foundation v. Blonder-Tongue Laboratories, Inc., 334 F.Supp. 47 (N.D.Ill. 1971), (pending in the Seventh Circuit Court of Appeals, No. 71-1829). Although Judge Hoffman in that case had initially upheld a patent which had been previously invalidated by an Iowa federal court, and although the Seventh Circuit had affirmed Judge Hoffman's decision, upon remand he applied the Supreme Court's decision and entered summary judgment for the defendant on the basis of the Iowa court's prior judgment of invalidity. In doing so he rejected the argument that the second case involved different claims than the first one, considered the exceptions left open by the Supreme Court, and found them unsatisfied, as this court does in the case at bar. This result, incidentally, conformed to that reached by the Eighth Circuit Court of Appeals which had in the meantime affirmed the Iowa court.

Plaintiffs attach a number of affidavits to their brief to demonstrate a lack of crucial evidence and witnesses in the Nebraska litigation allegedly not due to the fault of the plaintiffs. What plaintiffs really argue is that the attorneys (and plaintiffs) in the Nebraska law suit did not uncover all of the existing evidence during the seven years that the suit was pending. Much of the information allegedly newly discovered from the defendants in this cause was a matter of public record or was otherwise known to plaintiffs, and most if not all of it was in existence and discoverable during the Nebraska litigation. If plaintiffs could demonstrate that the pending litigation was made possible by new facts or change of circumstances which did not exist at the time of the trial in 1969, their argument under this point might have merit. But as it is, the argument merely says that plaintiffs' attorneys in the present suit believe they could do better by a second effort. To litigate this issue here would be a step backward toward trial by combat and is not what the Supreme Court intended.

In the last analysis, the Supreme Court has told the federal judges to decide questions of collateral estoppel in patent cases on the basis of the trial court's sense of justice and equity (402 U.S. 313, 91 S.Ct. at p. 1445). The justice in this matter is pre-empted by the *Blonder-Tongue* decision itself, together with the exceptions mentioned therein and this court's determination that the decision is to be applied retrospectively. The equities in this matter militate heavily against the plaintiffs. They have had the benefit of their patent since 1957. They have filed several suits to enforce it, all of which were settled beneficially to the plaintiffs. They elected to file yet another suit in the Nebraska federal court. They left that suit pending for seven years in a jurisdiction which had no backlog. They had ample time for nationwide discovery and taking deposition testimony. They went to trial and lost on the merits after a full and fair

hearing. They abandoned their appeal shortly before filing the case at bar in which they hoped, by a class action, to recover damages far in excess of the million dollars or so sought in Nebraska. They had enjoyed the benefits of a patent for almost thirteen years before their come-uppance. In the opinion of this court they had not been treated unfairly by the law.

It is therefore ordered, adjudged and decreed that defendant's Motion for Summary Judgment is granted and judgment is entered on the Complaint in favor of the defendants.

BOURNS, INC., a corporation, and Marlan E. Bourns, an individual,
Plaintiffs,

v.

DALE ELECTRONICS INCORPORATED, a corporation, Defendant.
Civ. No. 01432.

United States District Court,
D. Nebraska.
Dec. 29, 1969.

MEMORANDUM

RICHARD E. ROBINSON, Chief Judge

This matter was tried to the Court without a jury. The Court has been presented with testimony, documentary evidence, depositions and a series of briefs and is now ready to announce a decision, making the following findings of fact and conclusions of law.

Jurisdiction is vested in this Court by virtue of 28 U.S.C.A. § 1338(a), plaintiff, Bourns, Inc., and Mr. Bourns individually being citizens of the State of California and

defendant, Dale Electronics, Inc., being a citizen and having an established place of business in the State of Nebraska. This is an action for infringement of plaintiffs' patents numbered 2,777,926, 2,935,716, 2,953,763, 3,161,849 and 2,898,569. Defendant asserts by way of defense that the patents are invalid and non-infringed. It also defends by attempts to establish misuse, concealment during the formulation of military specifications and laches.

Certain motions have been made since trial and should be disposed of prior to stating findings of fact and conclusions of law. Defendant filed a request for oral argument for the purpose of allowing the parties an opportunity to summarize their respective positions. Because this case has been thoroughly briefed by each side the Court saw no need for further argument and orally so notified the parties. For purposes of the record that motion is now overruled. Plaintiff has also filed two motions to reopen trial and to offer additional evidence. Plaintiff's first motion relates to a pamphlet which plaintiff claims would state that teflon would be a material suited for use as a slider. Defendant states that should such case be reopened it would then have to attack the publication foundationally and then possibly present a countervailing opinion. The second motion relates to the admission into evidence of a letter which would be offered to show proof of the concept that compliance with military specifications does not require infringement. Defendant again states a wish to attack foundationally as well as further reasons for cross-examination. Because, as will later appear in this opinion, the Court does not believe the material presented to be of such a controlling nature as would probably induce a different conclusion the motions will be overruled. Neither motion and the evidence which may be admitted would effect the decision as written and therefore no good purpose would be served by prolonging a matter in which a decision is long overdue.

It has also come to the Court's attention that the entry into evidence of plaintiff's exhibit 105 was not allowed after certain deletions were made. No objections were received after the deletions. For the record that exhibit should have been received and the record should now so indicate.

Patent No. 2,777,926.

Plaintiff relies upon claims 1, 2, 11, 14, 15, 16 and 20 of the '926 patent. Defendant's primary thrust centers upon the validity of the '926 patent. Defendant's contention, among others, is that this patent is obvious. Non-obviousness is an element necessary for patentability under 35 U.S.C.A. § 103. The Court recognizes the presumption of validity as a result of allowance of the claims by the patent office and that the burden rests heavily upon the defendant to overcome that presumption in order to obtain a favorable decision. Superior Concrete Accessories, Inc. v. Richmond Screw Anchor Co., 246 F.Supp. 104 [W.D.Mo. 1965] aff'd 369 F.2d 353 [8th Cir. 1966]. However, this presumption will not stand in the face of compelling facts. "In such a case the court is not obliged to yield its judgment to a presumption which merely arises from the patent itself." American Infra-Red Radiant Co. v. Lambert Industries, Inc., 360 F.2d 977 [8th Cir. 1966]. In determining the validity of the patent this Court must ascertain the essence and scope of the patent as stated in the above-mentioned claims. Once having determined its essence it is then necessary to establish, among other elements, whether the patent, as defined, is obvious using the guidelines laid down by the Supreme Court. Graham v. John Deere Co., 383 U.S. 1, 86 S.Ct. 684, 15 L.Ed.2d 545 [1966] and restated by the Eighth Circuit in National Connector Corp. v. Malco Mfg. Co., 392 F.2d 766 [8th Cir. 1968].

The basic instrument involved in this litigation is a lead-screw-adjusted potentiometer [LSAP] which has for its

general purpose adjustments to tune a circuit to a desired result. The first question is then, what is the essence of the patent. A patent is limited to the invention described in the claims approved read in light of the specifications, Motion Picture Patents Co. v. Universal Film Mfg. Co., 243 U.S. 502, 37 S.Ct. 416, 61 L.Ed. 871 [1917]. The Eighth Circuit has further stated that:

> "[A] patent is not a mathematical measurement. It is a *conception* reached by consideration of the combined effect of the state of the art, the contributions as revealed in the language of the patent to one skilled in the art, and any limitations imposed and accepted during the progress of the application through the Patent Office." General Motors Corp. v. Kesling, 164 F.2d 824, 832 [8th Cir. 1947].

It is helpful in order to fully understand the scope of the patent as well as its validity to state the factors which distinguish each claim from the others. Claims 1, 2, 14 and 15 all contain basic elements of a potentiometer. They all contain a housing member having two opposite, substantially flat sides, a resistance element, conductor [claim 1 only], a slider, a screw to move the slider with spring contact members on the slider and a means for making an external connection [Claims 1 and 2] through a side or end of the housing or an opening extending transversely through the housing to receive a mounting post.

Claim 11 is similar to the above claims except that there is no housing stated and there is added "a pair of upstanding portions at opposite ends thereof." It also contains a "means engaging said screw means to prevent longitudinal movement thereof while permitting rotation thereof"; also a "means restraining the slider against rotation."

Claim 20 has the basic elements found in 1, 2, 14, and 15 but adds to that, without mention of mounting holes, that

the resistor is capable of being "adapted to be assembled in juxtaposition with other like resistors." This description presumably explains the size, configuration and ability of the devices to be stacked or mounted easily either alongside or on top of each other.

Claim 16, while also similar, includes language that the cover cooperated with the housing to form a conduit in one side of the housing.

Throughout all except claims 16 and 20 reference is made, in addition to or in conjunction with what has been already stated, to the mounting holes or openings which generally extend transversely through said housing perpendicular to the flat sides and is used to receive a mounting post in order to permit close and rapid assembly. Claims 1 and 2 are somewhat different in language in that there are holes both perpendicular and parallel to the flat side portions still having the same purpose of close and rapid assembly.

Commencing with the history and progress of this application through the patent office as finally embodied in claims 1, 2, 11, 14, 15, 16 and 20, it provides some insight into the scope of the patent. Bourns initially submitted eighteen [18] claims all of which were rejected. The Patent Examiner in so ruling relied primarily upon and cited patent number 2,357,433 [the Side Patent] stating that the Bourns '926 patent was unpatentable over the prior art. Of the original eighteen [18] claims Bourns amended two [originally claims 2 and 3 and now claims 1 and 2]. These claims were amended to include mounting holes which were placed on adjoining sides to permit close and rapid assembly with other variable resistors. Also additional claim 22 [present claim 11] was submitted without any provision for mounting holes. Claims 2 and 3 were accepted [becoming claims 1 and 2] and original claim 22 was amended to include the

mounting holes. Also, new claims 29, 30, 31 and 38 which subsequently became 14, 15, 16 and 20 respectively were also submitted. Claims 29 and 30 included mounting holes but were different to the extent that not only was there an opening but that opening extended completely through the housing enabling the receipt of a mounting post. Original claims 22, 29 and 30 were accepted and became 11, 14 and 15. Claims 31 and 38 were rejected. Claim 31 [now claim 16] was then amended to include a housing and its cover which formed a conduit on one side of the housing. After the amendment that claim was also accepted. Claim 38 was also amended. It read closely upon the Anderson and Dietrich patents [see file wrapper of '926 patent] and after minor wording changes was also accepted. It originally contained functional language pertaining to the mounting holes.

From a reading of the allowed claims and the history of the patent as it passed through the patent office it seems apparent that the mounting holes are the elements [excepting claim 16] of the patent which the Patent Examiner believed to be the essential feature which made the patent acceptable. The patent office cited the Side Patent as containing all of the elements of the Bourns '926 patent until the amendment to include the mounting holes or a rearrangement of the parts to allow an opening extending completely through the housing. Whether the Patent Examiner believed the mounting holes themselves to be unique or because of the arrangement of the components of this specific device to allow room for the mounting holes it is not necessary to decide. This Court believes both interpretations require a decision rendering the patent invalid.

Even if the history of the patent's progress would not be sufficient to show that the essence was principally a rearrangement of components of a device, not in itself

patentable, which would allow for ease and flexibility in mounting, the statements of the inventor himself should further show beyond doubt that the device was not patentable. An inventor's own appraisal of what he considers to be the nature of a patent is of prime importance and is to be given great weight. Goodwin v. Borg-Warner, 157 F.2d 267, 269 [6th Cir. 1946]. See also Deller's Walker on Patents 2d ed., Vol 4, § 228 [Baker, Voorhis 1965]. The inventor, Mr. Bourns, stated during the course of the trial that, after returning from a business trip, where there were some objections to the means of mounting the device, he caused the device's components to be rearranged in order to allow for the mounting holes passing completely through the housing without altering the overall size. He further states, later in the record, that the essence of his invention and his contribution to the art was in "taking all these incompatible parts and changing their size and proportion and bringing them together in a single embodiment" [Record pp. 138, 139].

A further remark should be made regarding the language of the patent claims and the history of the patent. Plaintiff has claimed that there are additional advantages or attributes to the LSAP. He claims self-locking adjustment, immunity from shock, and ease of adjustment combined with its miniaturization in order to conserve space. While these may be attributes they are not included in the claims. This situation is thus similar to that found in National Connector Corp. v. Malco Mfg. Co., 392 F.2d 766, 769 [8th Cir. 1968] where the Court said that while such factors may be asserted to be attributes they are outside of the specific claims of the patent itself. The Circuit Court there stated that the scope of the patent must rest upon the claims as stated and accepted by the patent office. Even though it may have other inherent attributes, they are not within the

scope of the Patent. It should also be stated that Malco recognized that the use of "subtests", such as are here concededly present [great commercial success and a need for such a device in the trade] are not persuasive "if prior art anticipates or otherwise makes obvious the attributes of the improvement involved". National Connector Corp. v. Malco Co., supra, at page 769.

Once having discussed the language of the claims, and the evidence relating to the scope and essence of the patent as adduced from the history of its passage through the patent office, it now becomes necessary to pass to another area for consideration, namely, the state of the prior art at the time of the claimed invention.

The evidence and facts below presented which relate to the prior art have been considered to determine if there is any reasonable construction which may be given to the patent claims which would allow the Court to declare it valid. The prior art is also considered to limit the scope of a patent if there are some grounds for declaring it valid.

Defendant has presented numerous patents in addition to those cited by the patent examiner. In themselves the patents cited by the Examiner are persuasive as to what the limits of the '926 patent should be. However, with the limits defined, as deduced from the patent application, then defendant's presentation of numerous additional patents, which read on the patent as defined and which have not been cited by the Patent Office, considerably weakens if not dissolves the presumption of validity.

Bourns Model 115 CT.

As testified by plaintiff's witness, Mr. Hardison the Bourns 115 CT potentiometer was basically the same as the '926 patent [mounting holes excluded for the present] with the exception of the push-pull rod type of mechanism rather

than the leadscrew. This difference did provide, in the '926, greater measurement accuracy and resistance to vibration. However, even though plaintiff's device shows greater ability to exact fine measurements and resistance to vibration these are not factors contained in the claims and cannot therefore be considered as part of patent to be protected.

The Kiefaber Patent.

This patent would seem to fill any gap in the state of the art because of the presence of the leadscrew rather than a push-pull rod. Mr. Hardison testified that the leadscrew in the Kiefaber patent had essentially the same purpose as the leadscrew in the '926 patent. In addition, this patent contained many of the elements contained in the '926 patent, namely, a base member, conductor, resistance element, screw means to prevent longitudinal movement, slider having threaded engagement with the screw, spring contact members on slider for wiping resistance element, means for restraining the slider against rotation and where the turning of the screw causes spring contact members to travel over said resistance element and conductor. This patent then, with the exception of the mounting holes and possibly the size of the device, reads extremely close to the '926 patent.

Defendant has also entered in evidence the claims and characteristics of many other patents. The Thompson patent has similarities in that it has a housing resistance element, slider with spring contact members and a means for making external connections. This patent as well as those above cited and the many also presented bear a sufficient resemblance in purpose and design that there is no room in the art for any interpretation of the claims of the '926 to sustain its validity unless it may be found in the

reorganization of the components or in the mounting holes. The mounting holes would seem to be the only gap in the art where a nonobvious device could be held patentable.

Now, regarding these mounting holes, defendant has shown that the Bourns 115 CT device has single holes which are made to receive mounting posts and screws which would secure the device to another instrument. These holes, however, as defined, do not allow for an opening extending transversely through the housing which would then be capable of receiving a mounting post. The laboratory potentiometer entered as evidence to show similarity to the '926 has mounting holes which essentially amount to screwholes in the legs but this is a far cry from a hole passing entirely through the device and thus being capable of receiving mounting posts. The prior art here presented does not evidence that type of mounting hole passing entirely through the device. This is the case in some of the claims of the '926 patent.

Thus reviewing the limitations resulting from the amendments to applications made to the patent office after previous rejections of claims, together with an interpretation of the language in the claims as stated by persons skilled in the art as they relate to the wealth of prior art in the field, it is clear that the '926 patent in order to be valid must be held to be specifically and narrowly defined and limited by the claims. As stated, the evidence revealed readings on the prior art which were recognized by the patent examiner which resulted in their initial rejection. Subsequent amendment of claims, in order to escape rejection, as earlier outlined, then resulted in a limitation by amendment. See Deller's Walker on Patents, 2d ed., Vol. 4 § 234 [Baker, Voorhis 1965]. The language of the claims reveals readings on the prior art in addition to that found by the patent examiner and if this patent is to be declared valid it must

be narrow, so narrow as to be limited by the later amendments and the state of the prior art. This Court believes that, by the limitations evidenced in prior rejections and the interpretation by experts of the language as it relates to the prior art, fortified by the statement of the inventor of what he believed the essence of the patent to be, the patent to be valid must rely upon its size or composition which allowed for rapid mounting with ease of adjustment and in some of the claims on ability of the device to be mounted in close proximity to others. The language of the claims which calls for a hole passing transversely through the housing is related to size and composition. It is nothing more than a rearrangement to allow a pole to pass through. In itself it cannot be claimed that a hole for mounting without some other difficulty or definition is sufficient to rise to the dignity of a patent. The above remarks relate to all of the claims except 16 which is to be treated separately.

Once having reached a conceptual rather than a mathematical formula type understanding of the nature of the patent, if we were to apply the test for obviousness as laid down by the Eighth Circuit in the *Malco decision,* assuming, as in that case, novelty and utility were established this patent could not be declared valid. The "scope and content of the prior art," already indicated by the Thompson, Kiefaber and Bell as well as others, prevents any broad construction. If the claims are given a limited and narrow construction as earlier stated which this Court believes to be the true construction plaintiff is precluded from relying upon a difference in configuration to allow mounting holes extending completely through the device or by stating the purpose of this configuration to allow rapid assembly or the devices to be placed in juxtaposition with each other. "Changes of mere form, proportions or size will not sustain patentability." National Connector Corp. v. Malco Mfg. Co., 392 F.2d 766 [8th Cir. 1967]; Gerner v. Moog Industries, Inc., 383 F.2d 56 [8th Cir. 1967].

In regard to claim 16, it was continuously rejected by the patent office until the language of the claim was amended to include that a cover for the device cooperated with the housing to form a conduit in one side of the housing. Until this change the language is essentially the same as that of the other claims less reference to mounting holes. In light of this history, this Court finds it hard to believe that the laying of wires in an open slot or their passing through a hole is such a unique design as to rise to the dignity of a patent. This writer would have to agree with the expert witness that the advantages of this aspect would be apparent to one skilled in the art of fabricating such devices. There is therefore no validity to claim 16 and the '926 patent is held to be invalid.

The 3,161,849 Patent.

Originally plaintiff based its action upon claims 12, 15, 16 and 17 of the '849 patent. After trial plaintiff, in view of the trial testimony, concedes claims 15, 16 and 17 are not patentable after disclosure of the Bourns Patent #2,935,716. The only claim remaining therefore upon which to uphold the validity of the patent is claim 12.

Defendant's thrust at this claim of the patent also centers on its invalidity. Defendant's attack is fourfold. It claims obviousness in light of previous similar patents; prior use by virtue of testimony of a Mr. Elliot who allegedly manufactured and sold similar instruments prior to the conception of the '849 patent; admissions of invalidity of claims 15, 16 and 17 should also be applied to claim 12, and finally laches.

After a review of the evidence which shows the similarities between the '849 patent and all of the prior patents and the devices allegedly manufactured and put into circulation prior to the '849 patent, the validity of this patent

hinges upon certain language in the Second Means of claim 12. It reads: "A terminal device comprised in said terminal means being constructed and arranged as a bearing to rotatably support the first end of said leadscrew and serving to conduct electrical current conducted by the leadscrew." It is the plaintiff's apparent claim that this is the factor which distinguishes his device from the prior art, that is, the performance of a double function of rotatable support and conducting electricity by the terminal means. Without an undue detailed statement of the evidence it is sufficient to state that the state of the prior art and the statements of individuals experienced in the field as to what would be obvious to someone knowledgeable in the field demonstrates striking similarities with the patent here claimed. The Semple and Kiefaber Patents, as explained by experts in the field together with designs and expert's explanations of devices, conceptualized and reduced to writings and drawings prior to any conception of this patent, compel the holding of the '849 patent as invalid.

There are Three Means which make up claim 12 but the First and Third Means contain nothing more than the standard elements of a leadscrew adjusted potentiometer and thus based upon findings as to this patent and the '926 do not distinguish the devices there explained from the prior art. Discussion is therefore limited to the Second Means of claim 12.

Defendant claims that when plaintiff declares claims 15, 16 and 17 to be invalid they then enter into the public domain. Once they have entered it is his contention that nothing remains of claim 12 which is not contained in 15, 16 and 17 and is therefore invalid. The Court does not believe that this contention in itself is sufficient to render claim 12 invalid. A reading of the language of 15, 16 and 17 does not reveal the claim of a double function of the

terminal device mentioned in claim 12. The Court does note however and as was noted by the Seventh Circuit Court of Appeals in Hoover Company v. Mitchell Manufacturing Company, 269 F.2d 795, 803 [1959] that "this is another circumstance which detracts from the contention relative to the meticulous care which was exercised in the Patent Office" and that therefore it will effect the presumption of validity.

The next of defendant's contentions relates to anticipation as found in 35 U.S.C.A. § 102 [a]. Again it is apparent at the outset that there is a heavy burden upon the party attempting to establish prior use. FMC Corp. v. F. E. Myers & Bro. Co., 384 F.2d 4, 10 [6th Cir. 1967]. In light of the publications with accompanying design charts and the testimony of the producer and other experts in the field the record is clear and the burden has been met.

The claim of a prior use centers upon two potentiometers produced by a Mr. Elliot while associated with California based Wellan Corporation. Plaintiff admits conception and first drawing of its patent to be about February 1st, 1956. Defendant claims prior use during 1954 and 1955. The two potentiometers upon which this contention centers are described in the record as Exhibits A-78 and A-81. Plaintiff contends that while the drawings of the construction of A-78 device are sufficient to show the similarities of construction detail there is not sufficient evidence to meet the burden of proving prior manufacture and sale. The contentions regarding the A-81 device are just the opposite. Plaintiff does not contest ample evidence of prior use but contends that the evidence of construction similarity is not sufficient to meet the burden.

The evidence relating to the construction of the A-81 design centers upon freehand drawings by Mr. Elliot made from memory just prior to the trial. He also had available

detailed sketches of the A-78 design which contained basic similarities but to which were added certain improvements then embodied into the A-81. This Court determines that the testimony of Mr. Elliot and his memory sketches are sufficient to meet the burden of proving anticipation prior to the conception of the Bourns '849 patent. The evidence relating to the construction of the A-78 design is likewise sufficient. Both devices contain the basic potentiometer equipment, are sealed against humidity etc., have a "hot leadscrew" and have a terminal device which both rotatably supports the leadscrew and serves to conduct current from the leadscrew. Regarding the prior use of these devices no question arises as to the A-81 as the plaintiff concedes, and the evidence amply supports, its prior use. Plaintiff contests, however, the prior use of the A-78. Mr. Elliot testified that there were limited sales of the A-78 prior to the A-81, he states that they were sold to at least four companies and that numerous samples were distributed. He states, with no evidence to the contrary, that it was the practice in the business to distribute some samples in order to generate interest in the product. Mr. Elliot further testified that he revealed the components and a description of the A-78 to a Mr. Butler prior to 1956. Mr. Butler testified as to the time of a disclosure but could not specifically confirm or deny the exact potentiometer or its exact components other than that they were similar. The Court believes however that Mr. Elliot's statements of prior sale and his statements regarding the disclosures to Butler confirmed generally by Butler establish prior use even though records of sale were unable to be produced.

Defendant has also claimed that the state of the art prior to the '849 patent establishes obviousness. As earlier stated the Kiefaber patent and the Semple patent, together with the testimony from Mr. Hardison relating to these patents and testimony from Mr. Carter as to what equipment or

elements of a potentiometer would have been obvious to one engaged in that business, establish defendant's contention.

Plaintiff's defense to this claim also centers around the language previously stated from the Second Means of claim 12 pertaining to the terminal device having a double function. The remaining features of the '849 patent are all obvious in light of the prior art evidence. See Mr. Hardison's testimony concerning the Kiefaber patent [R. pp. 356-58] and Semple patent drawings [A-170 to 186]. Regarding the double function terminal, Mr. Hardison specifically testified that Kiefaber performed both functions. Any claim as to reduction in size and configuration is without merit as previously discussed in regard to the '926 patent. Additionally, it may be seen from examining the drawings of the Elliot designs that those terminals accomplish both functions. The one factor not previously discussed is the reference to a sealed and insulated housing. This is present in the Semple patent. Additionally, Mr. Carter testified that it would be obvious to a designer in the field to enclose the device to protect it from foreign matter and therefore prior art. Accordingly and without reaching the issue of laches the '849 patent is held to be invalid for either one or both of the above contentions.

The 2,953,763 Patent.

Only one claim [claim 6] is in issue under the '763 patent. The claim states an improvement upon the basic '926 patent and involves the prevention of "end play" coupled with a more rapid assembly process for these precision potentiometers. By the use of the bowed spring with a "U" shaped notch there is a bearing or tension placed upon the leadscrew which holds it firmly in place as well as allowing, after preassembly of the leadscrew and wiper, easier and more rapid assembly by workers on the assembly line. Defendant claims the patent to be invalid because of the prior art.

The Court believes that defendant's presentation of prior patents which have similar functioning as explained by the experts is dispositive of the issue of invalidity in its favor.

Prior to the putting into practice of the '763 patent there were devices in the potentiometer field and somewhat related fields [to be discussed] which had for a purpose, although not their sole purpose, the placing of tension or pressure upon a shaft or leadscrew to prevent movement or vibration. See "O" Ring used by Wellan Corporation [previously discussed and held to be prior art in conjunction with the '849 patent] and Fay patent 2,717,983.

Regarding the Fay patent the plaintiff does not seriously contest the similarities between it and claim 6 of the '763 patent. A study of defendant's exhibit A 192-10 [fig. 2] and a reading of the Fay specification reveals a "U" shaped clip and a purpose of bringing tension upon the shaft in order to reduce "end play." There are still however certain questions remaining to be answered. Does the Fay patent also cover the advantage of rapid assembly? Would it be obvious to substitute the "U" shaped clip in a potentiometer when the Fay patent is from a different although related electronic field?

Mr. Carter, defendant's expert, testified that it would be obvious to transfer the Fay "U" shape to an Oler patented device which was in the potentiometer field and further stated that it would be obvious in the situation where the desired effect was a speed up in assembly to substitute the Fay function. This testimony was substantially uncontradicted. It was pointed out however that while the Oler patent's function would appear and was stated to have brought tension upon the shaft or leadscrew it did not. It was however, still a device in the potentiometer field. Mr. Carter's testimony therefore illustrates that the transfer of a function from the similar field in which the Fay patent

is found to the potentiometer would be obvious in that it would speed up assembly and place tension on a leadscrew or shaft to reduce motion and vibration.

Regarding the Wellan Corporation patent, as found in exhibit A-78 testimony was received that the "O" type ring, in addition to providing a seal from foreign substance, also acted to prevent movement of the leadscrew. While this patent then has the capacity to prevent vibration it could not be rapidly assembled. Were this patent then relied upon to solely represent the art prior to the '763 patent the '763 patent would be left with the changing of what was before an enclosed "O" Ring to an open "U" ring so that it can be more easily assembled. Mr. Elliot, former Vice President of both Wellan and Dale, testified [A-349 pp. 49-55] by way of deposition that there are many instances of "U" shaped springs used on shafts. His deposition would indicate this to be a common design practice and should a person desire to place the spring later in the assembly that the open "U" would be the more common and practical design. The change, therefore, as the Court understands the facts, is that the "U" shape is common design not requiring any great expertise or great transition from the "O" Ring. Indeed even the "O" Ring itself is no great mechanical achievement. Mr. Elliot compares the spring tension strip pressing against the housing as a rather common practice similar to springs found in automobiles and chairs to prevent movement and vibration.

The Court therefore finds that the '763 patent is obvious under 35 U.S.C.A. § 103, even in light of the presumption against invalidity, when compared with the prior art as found in the Fay patent and when it is found that it would be obvious to one skilled in the art to transfer the function of the "U" shaped clip of that patent to a device like the '763 in the potentiometer field. The test for transition from

one field to another seems to be whether the prior art relied upon is so remote as to require invention to make the necessary substitution or whether the investigators would naturally have looked to the field of the Fay patent for help. In re Shapleigh, 248 F.2d 96, 45 CCPA 705 [1957]; General Metals Co. v. S. K. Wellman Co., 157 F.2d 505 [6th Cir. 1946]; In re Schneider, 47 F.2d 970 [C.C.P.A. 1931]. Even without Mr. Carter's testimony it would seem obvious to the Court to search a related electronics field for a device to control vibration and speed of assembly. It is not the type of a function which would be peculiar to a particular type of instrument but rather one that would be used in a variety of instruments all having the desired effect of controlling vibration. Mr. Elliot's statements of the basics of the principle involved also support this belief.

The Court also finds, separated from the Fay patent, that the Wellan patent as found in A-78 has the characteristics of vibration prevention as found in the '763 patent and at an earlier date than the '763 [as discussed with the '849 patent] and that the cutting out of a slot in the "O" Ring to form a "U" and thus provide ease of assembly is not so nonobvious as to be patentable. The "O" Ring itself is not even nonobvious. [See again Elliot dep. Ex. A-349 [pp. 49-55]. Under the principles as enunciated in *Malco* either the prior art of Fay or Wellan coupled with the non-inventiveness of a strip spring open at one end because it would be obvious to one skilled in the art require this Court to hold the patent invalid.

Patent # 2,898,569.

Claim number three is the only claim in issue under this patent. At the outset the Court holds that the patent is invalid. The prior art totally reads on the claim. Defendant's argument relating to prior art centers upon a Bourns

patent # 2,860,217. Plaintiff does not attack the fact that the '217 and '569 patents have elements that do substantially the same work in substantially the same way as required by 35 U.S.C.A. § 102. In order that there be no doubt this Court holds that they do have elements that do substantially the same work in substantially the same way. The Court would place particular emphasis on the similarities of a plastic slider block of a resilient material which is self-threading or capable of being self-threading and which rotates around the leadscrew.

What plaintiff does contend, however, is that the '217 patent is not prior art. Again, as this Court understands the rules of priority governing patents it holds that the '217 patent is prior art. The matter revolves around the dates of conception and reduction to practice of the respective patents. The essential facts as found in the evidence show that Mr. Royce, the inventor of the '569 patent, started work on the invention in December of 1955; that the date of conception was claimed as mid-1956 at the earliest; and that it was reduced to practice at the earliest in the spring or summer of 1957. Regarding the '217 patent the only date here important is November 19, 1956, which is the filing date of that patent.

It is the rule that the filing of an application with the patent office is constructive reduction to practice. Deller's Walker on Patents, 2d ed. Vol. 1 § 47 [Baker, Voorhis 1964]. The '217 patent was therefore, at the latest, reduced to practice on November 19, 1956. Defendant admits that the '569 patent was not reduced to practice until the spring or summer of 1957. Were reduction to practice to be the sole test of what constitutes prior art the '217 patent would then obviously be prior. The fact that the inventor of the '569 patent had no personal knowledge of the anticipating matter when his patent was reduced to practice is immaterial. He

is presumed to know the prior art even if he had no actual knowledge. Deller's Walker On Patents, 2d ed., Vol. 1 § 73 [Baker, Voorhis, 1964].

The first to reduce to practice is not, however, always the first inventor.

> "I first conceiver must use reasonable diligence in reducing his idea to practice in order to entitle him to a patent as against a subsequent conceiver who has first reduced his invention to practice. If the first inventor of a device exercises reasonable diligence in reducing it to practice, he does not lose his right to a patent because a second and independent inventor of the same device may have first put it into actual use. The man who first reduces an invention to practice is *prima facie* the first inventor. However, the inventor who first conceives an invention will be considered the first inventor if he uses diligence in reducing his invention to practice. If a rival inventor enters the field, then the first conceiver must use diligence before, as well as after, the conception of the invention by the second inventor." Deller's Walker on Patents 2d ed. Vol. 1, § 51 pp. 221-22 [Baker, Voorhis 1964].

Initially the writer notes also that if the burden is upon the plaintiff to prove diligence from conception he should also have the burden of showing the date of conception. See Helene Curtis Industries v. Sales Affiliates, 233 F.2d 148, 156 [2d Cir.] cert. denied, 352 U.S. 879, 77 S.Ct. 101, 1 L.Ed.2d 80 [1956]; United Shoe Machinery Corp. v. Brooklyn Wood Heel Corp., 77 F.2d 263, 264 [2d Cir. 1935]. Conception is generally defined as the formation in the inventor's mind of the complete operative invention or as the formation in the mind of the inventor of a definite and permanent idea of the complete and operative invention as it is thereafter to be applied in practice. Knowles v. Tibbetts, 347 F.2d 591, 593, 52 CCPA 1800 [1965]; R. C. A. v. Philco

Corp., 201 F.Supp. 135, 149 [E.D.Pa.1961]. As defendant has pointed out and this Court states, the plaintiff has not carried its burden of proof regarding the date of conception of the '569 patent. Plaintiff states the date to be mid-1956 but the evidence for that statement is exhibit A-58B dated July 6, 1958. That exhibit does not reveal the sophisticated characteristics claimed in the patent. The Court finds no other evidence sufficient to indicate conception of the '569 patent prior to the constructive reduction to practice of the '217 patent on November 19, 1956. Furthermore even if the '569 was conceived first it is still incumbent upon plaintiff to show reasonable diligence in reducing his idea to practice. He admits conception not earlier than mid-1956 but further admits the lapse of approximately a year before the device was reduced to practice. This burden of showing reasonable diligence also has not been met. No reasonable excuse for the delay has been shown nor is any evident. It does not seem to be unreasonable in this potentiometer field that a time considerably shorter than one year would be sufficient to reduce the instrument to practice. Over and above that the patent application was not filed for another six months after that. Any attempt to show a date of reduction to practice prior to the filing date is also a heavy burden which plaintiff has neglected. See Ritter v. Rohm & Haas Co., 271 F.Supp. 313 [S.D.N.Y.1967].

The evidence therefore supports the conclusions that the '217 patent was first reduced to practice and plaintiff has failed to meet its burden of showing first conception and reasonable diligence in reducing to practice. The writer also states that a year is, under the circumstances of this case and the field in which this device is found, an unreasonable delay in reduction to practice. The Court would only further add that the patent office made no reference to the '217 patent when allowing the '569 patent and that this fact

coupled with any of the above conclusions is more than sufficient to overcome the presumption of validity attached to patent office grants of patents.

Defendant has raised other arguments concerning the validity of this patent and also that it, if it were to be declared valid has not infringed. As has been previously stated it is important to determine the scope and essence of the patent. The only claim in issue reads as follows:

> "In a construction including a movable member positioned upon a threaded shaft so that as said shaft is turned, said movable member is caused to move along the length thereof by the threads of the shaft, the improvement which comprises: a movable member of non-conductive material having sufficient resilience so as to undergo *temporary deformation* when in pressure contact with the threads of said shaft, said movable member being formed with an elongated opening of uniform cross-sectional configuration to receive said shaft, said opening being formed so as to extend entirely around said shaft, said opening being formed so that at least a part of said movable member is engaged by said shaft and deformed thereby, the resilient material of said member being displaced between the threads of said shaft down into the space between the crests and valleys of said threads."

Plaintiff has not seriously claimed that there is anything rising to the dignity of a patent as a result of this claim except that the slider block, made of a resilient material, has certain qualities not before present in the field which would lengthen the life of the instrument. Essentially plaintiff claims that this slider, when it reaches a point when it cannot move forward any further along the axis of the leadscrew, but the leadscrew itself continues to turn, will, when the leadscrew reverses direction either form new grooves in the block or jump back to the previous

grooves. Thus the material of the slider block would allow the potentiometer to function after ratcheting has occurred.

While it is not exactly clear whether the use of these materials actually allows the functioning of the device to continue it is clear that the flexibility and relative softness of the material is the reason for any possibly functional continuation of the device. When comparing the plastic or nylon material to steel blocks or units through which steel screws turn it is easy to see that once the grooves of those types of nuts are stripped there is no possibility of future operation of the device as is true with a resilient material.

If plaintiff's discovery works as he claims then the only real discovery is use after ratcheting in potentiometers. The use of an elastically deformable material is not new to this general field. When processing the '569 patent the patent office recognized the

> "use of a member formed of an elastically deformable material engageable by the threads of a leadscrew so as to take an impression of the threads whereby rotation of the leadscrew causes the member to move lengthwise." [See Ex A-282 p. 15 citing the Wallin and Gotschall patents].

There is no new product possessing any greater resiliency. The patent description states only generally the types of material and prior art indicates the use of these materials in many fields where a screw device is inserted into a solid or pre-formed resilient block but the difference which plaintiff claims is that these prior devices never had to cope with the problem of functioning after ratcheting or at least that it was not revealed in these prior patents [excluding the '217 patent previously discussed]. This Court is thus faced with the question of whether or not it would have been obvious to one skilled in the art to use a resilient material as described in the '569 patent to prevent a malfunction after

the block cannot move any further but the leadscrew still continues to turn? It is essentially an additional claimed advantage for an old product. Because of the flexibility of the product it may function even after the grooves of the block have been at least partially stripped.

In addition to the patents cited by the patent examiner defendant has presented an additional patent in the potentiometer field [see Zupa patent # 2,802,503, exhibit A-193-20] and others where the similar basic principle of inserting a screw into a resilient block is utilized [See exhibits A-193-12, 15 and 16]. While these instruments in the prior art do not necessarily state the ratcheting effect or even utilize it they show the similar principle behind ratcheting. Because the material is flexible ratcheting may occur and the device may still continue to function. These patents show the use of the resilient material precisely because it is soft and will allow the screw to move through and make it own grooves thereby being self-threading. Merely because plaintiff's claimed use continues to make new grooves or is flexible enough to continue to give under added pressure does not so distinguish his use that it is not, in the belief of this Court, obvious to one skilled in the art. The material is the same. The principle still is the same in allowing additional grooves because of the relative softness of the material. What plaintiff is claiming therefore is merely the making of more grooves after the block can no longer move forward and then additional grooves may be made when the rotation of the leadscrew is reversed. The Court should only further note, in order to be perfectly clear, that the claim of a continuous function after ratcheting is sufficiently rebutted in order to overcome any presumption arising from the '569 patent processing through the patent office.

There is one further point which should be discussed. As has been previously stated plaintiff's only claimed invention is functioning after ratcheting. And also, as has been previously stated, there is no other characteristics present which would allow the declaring of a patent valid. What bothers the Court is that it does not believe that claim 3 can be construed to include this claimed essence of the patent. There is no statement of this ability to function in this manner after the block runs up against one end of the instrument body or its ability to function after reversing the rotation of the leadscrew. If this is the real essence of the patent why is it not stated in the claim? Furthermore, as also has been previously stated, if the ability to function after ratcheting is the real essence of the patent that ability is merely an extension of the principle of using elastically deformable material. The patent office specifically refused to allow certain claims because they read on other patents using an elastically deformable material. Under the teaching of the *Malco* case, supra, the process of the patent through the patent office should be considered. Here anything based upon elastically deformable material could not be read into the claim. That consideration coupled with absolutely no statement of the effect which plaintiff claims is the crux of his patent would strike the mind as an afterthought and was not intended by either the patent office or the inventor to be stated as part of the claim. Nothing else being novel or not being present in the prior art the patent is also invalid for that reason.

The Bourns '569 patent is therefore invalid for any of the above reasons.

The '716 Patent.

This patent is an improvement patent on the basic LSAP. Only one claim, number two, is in issue. The essen-

tial elements of this claim, the patent being commonly referred to as the "mating halves" patent, are two housing members which cooperate together to journal the leadscrew therebetween. Plaintiffs state that in the original design, which was the '926 patent previously discussed, the leadscrew had to be inserted through a hole in the housing, then fed through the slider and finally into a bearing hole in the opposite end. It now argues that by being able to drop a pre-assembled shaft and slider in from the top there is a speed up and vast improvement in the manufacturing process. It also claims that, whereas before undesirable end-play, unnecessary movement, or rattling was difficult to control, the cooperation of the housing and cover reduces end-play without the maintenance of a close dimensional tolerance. The critical words of claim 2 thus are:

> "cooperating means on said housing engaging said shoulder means to prevent endwise movement of said leadscrew, said other housing member engaging said shaft to confine the same in place within said notch."

The patent here in question is allegedly either a divisional or a continuation-in-part patent which would entitle it to the filing date of the parent application which would be May 3rd, 1954. If plaintiff is not entitled to this early filing date then there seems to be little question but that the patent would have to be declared invalid. Defendant claims that the patent is not entitled to the early filing date because of plaintiff's execution of a false oath; because there are substantial additions to the divisional application not found in the parent application; and because the state of the prior art, namely the Bourns '926 patent, discloses clearly, even though accidentally, the invention here claimed.

As earlier stated, if this patent would not be allowed to be classified as a divisional or continuation patent thereby

allowing a filing date of May 3rd, 1954, the patent must be held invalid. Defendant has shown sale of their Dale Type I units in the summer of 1956 which the evidence shows to read upon the claim in question and plaintiff has admitted sales of the infringed patent in the summer of 1954. If the November 1957 filing date is the record filing date then the patent is invalid under 35 U.S.C.A. § 102[b] because of sales and use more than one year prior to the record filing date of the parent application having been proved.

The first question then is whether plaintiff's filing of an incorrect statement or oath at the time of the filing of the divisional application is a deficiency which would prevent the patent from being held valid. What actually occurred is that plaintiff filed the oath normally filed with an original rather than a divisional application which stated the invention was not in use or on sale more than one year prior to the filing of that application. The record is clearly to the contrary. As previously discussed there were sales prior to November of 1957, the actual filing date of this patent application.

There is some authority for the proposition that where there is an amendment to the original application and the subject matter of the added claim is not substantially embraced in the original application the absence of an oath accompanying the amendment is fatal to the patent. George Cutter Co. v. Metropolitan Electric Mfg. Co., 275 F. 158, 162 [2d Cir. 1921]; Balaban v. Polyfoto Corp., 47 F.Supp. 472 [D.Del.1942]. The situation here, however, is somewhat different. It is true that the plaintiff filed the wrong form of oath and represented no use or sales more than one year prior to his divisional application but in the same application stated that this was a divisional application arising out of a parent application three years earlier and having the

heretofore mentioned filing date of May 3, 1954. It would therefore be reasonable to assume that the filing of the wrong form was a clerical mistake for which the penalty of declaring the patent invalid should not be utilized. It is not necessary that an application verify that there was no use or sales more than one year prior to the filing of the divisional application but only that there was no sale or use more than one year prior to the filing of the parent application. This latter statement would be the reasonable interpretation of what the applicant meant to say and could reasonably be interpreted in that manner by the patent office in light of the statement that it was a divisional application. In those cases holding the failure to file the supplemental oath it was necessary that there be filed an oath stating that there was no sale or use more than one year prior to the filing of the amendments to the original application. Without some intentional misrepresentation evidenced plus the statement that it was a divisional application in the patent description the Court believes that this technical error is not fatal to the validity of the patent.

Defendant's second claim of invalidity is based upon the argument that substantial additions to the divisional applications were made. It believes that the Patent Office Rules And Practice § 147.2 and § 147.3 require that the subject matter of a divisional application be carved out of the original or parent patent. Defendant first claims that there are substantial changes between the wording of the final allowed parent patent and the final allowed divisional patent. It also claims substantial differences in the figure four in each of the patents.

The Court does not believe that wording substitution or changes is the appropriate test. It should be whether the design is substantially embraced in the statements of invention or claims of the earlier patent *application*, not, as

defendant cites, the *final allowed patent description, specification and claims.* The final claims and specifications as allowed, while they may reveal the divisional claim, do not reveal the divisional claim nearly as succinctly as the original application for a patent prior to the patent office requirement that an election be made. At that point it can be determined whether the divisional claim was revealed in the parent application. Whether or not the statement of invention there revealed in the parent application would anticipate the divisional claim would be an appropriate test. Walsko v. Smith, 102 F.2d 815 [CCPA 1939]. If the invention later claimed in the divisional patent is substantially carved out of the parent, regardless of word changes, then is is entitled to the parent filing date. Coltman v. Colgate-Palmolive-Peet Co., 104 F.2d 508 [7th Cir. 1939].

> "[T]he original application is the mother or parent application, and all claiming to be her offspring must show bloodstream connection with her. Unfortunately, the proof of the exact invention is not always clearly disclosed by the words used. When the solicitor's vocabulary is full to overflowing and words of both elastic and comprehensive meaning are chosen, it is difficult to lay down or apply a rule or a test by which it may be confidently said * * * the application and claims of a divisional patent, are for 'the same invention' or * * * conform to the original application." 104 F.2d at 515.

Realizing the difficulty, this Court determines that the invention claimed in the divisional application is substantially embraced in the statement of invention, specification, description and claims of the parent application. A review of the file wrapper of the parent application [Ex A–283] reveals that on May 31, 1957 the patent office decided that a restriction was required. Subsequently the applicant made an election. The letter informing the applicant of the

restriction divided the then existing claims into six groups. Group five was elected by the plaintiff. Group one, which then comprised claims 20, 35, 36 and 38, contained, at that time, similar language to the critical language of claim 2 of the '716 patent here in question. Claim 36 has almost identical language to the claim 2 of the '716 patent. Claims 20, 35 and 38 contain language that would embrace a design substantially similar to that as stated in claim 35 at least as far as the critical language previously mentioned. So that there be no doubt and in order that an issue not raised in the briefs will not later arise, namely the need for a supplemental oath with any amendment, there is also language in the original claims filed in May of 1954 that will allow the subsequent amendments here cited to substantially embrace the original application even though those claims were originally rejected for indefiniteness. See file wrapper for the '949 patent, original claims 7, 8, 14. The Court also states that the drawings as originally filed in 1954 have not been altered appreciably, contrary to defendant's argument. It argues that the figures four have been substantially changed. Any changes that have been made appear to have been made at the patent offices request for more exact explanations which would then require some minor changes in the figures.

This Court therefore holds that any additions or variations between the parent and divisional application are not so substantial as to prevent the divisional application from utilizing the effective filing date of the parent application.

Defendant's final argument rests on the proposition that, even though the '716 patent is entitled to a May 3rd, 1954 filing date, claim 2 of the '716 reads directly on the structure shown in figure 17 of the Bourns '926 patent, which is in the prior art prior to the parent application filing date. There is no reference in the claims, descriptions or specification

of the '926 to the structure allegedly disclosed in figure 17. Defendant's argument rests on the figure alone and a theory of accidental disclosure.

It has been held that it is immaterial whether the inventor realizes his disclosure. All that is necessary is the fact that a disclosure has been made. Deforest Radio Co. v. General Electric Co., 283 U.S. 664, 51 S.Ct. 563, 75 L.Ed. 1334 [1931]. However, an accidental disclosure is only available as a prior reference if "clearly made in a drawing." Application of Seid, 161 F.2d 229, 34 CCPA 1039 [1947]. It is also the law that a drawing alone, if it teaches to the art what the patentee claims in his invention, is sufficient for anticipation. Des Rosiers v. Ford Motor Company, 143 F.2d 907 [1 Cir. 1944]; In re Boyd, 55 F.2d 493 [CCPA 1932]; In re Bager, 47 F.2d 951 [CCPA 1931]; Jockmus v. Leviton, 28 F.2d 812 [2d Cir. 1928].

Plaintiff's basis for validity is reduced to the statement that this Court is unable to determine from the evidence that the disclosure, for purposes of anticipation, in figure 17 of the '926 patent is *clearly made* within the meaning of those words as stated in earlier precedent. The disposal of this issue hinges upon a small area marked with an "X" in exhibit A–298. If this small piece above the leadscrew is clearly part of the cover and not intended to be part of the housing then the remainder of figure 17 clearly discloses the remaining elements necessary for anticipation. See the testimony of plaintiff's witness Hardison, record pp. 337–345.

Plaintiff relies on some statements by the defendant's witness Carter that "[i]t is not clear whether it is a part of the cover or not." [R. 498]. This is the only place the Court can find in the record some doubt as to whether this piece was a part of the cover. Even this was later clarified by Mr. Carter's statements that the piece as depicted would be

as drawn in figure 17 if it was a separate piece but attached to the cover. Defendant, as to the remaining evidence successfully rebutted any argument that figure 4 and figure 17 of the '926 should have been drawn the same way [plaintiff claims a draftsman's error in figure 17] by showing numerour differences in design and structure between the two figures and a reasonable explanation to show figure 17 as drawn. Plaintiff claims the draftsman's error but there is no evidence of mistake or even intent by the inventor it should be otherwise other than what may be inferred from other evidence and plaintiff has successfully rebutted any rational inferences that could be drawn. Furthermore, the cover is metal and so is the piece in question according to the patent office guidelines for drawing what is plastic and what is metal. There is no requirement in the claims that the cover be one solid piece and it is definite that it is not plastic as drawn as is the base housing member unless there was evidence of mistake. The Court therefore concludes that figure 17 of the '926 patent is clearly disclosed and anticipates claim 2 of the '716 patent.

This Memorandum shall constitute the Court's findings of facts and conclusions of law under Rule 52 of the Federal Rules of Civil Procedure.

Counsel shall prepare an appropriate order and submit immediately.

UNITED STATES DISTRICT COURT

FOR THE

SOUTHERN DISTRICT OF IOWA

DAVENPORT DIVISION

Civil Action File No. 3-695-D

The University of Illinois Foundation vs. Winegard Company	Judgment

This action came on for trial before the Court, Honorable Roy L. Stephenson, United States District Judge, presiding, and the issues having been duly tried and a decision having been duly rendered.

It is Ordered and Adjudged that the plaintiff take nothing, and that the action be dismissed on the merits, and that Winegard Company, defendant, recover of The University of Illinois Foundation, plaintiff, its costs, exclusive of attorney's fees.

Dated at Davenport, Iowa, this 23rd day of June, 1967.

F. E. VAN ALSTINE
Clerk of Court

By ERNA HEIFER
Deputy Clerk

JUDGMENT

UNITED STATES COURT OF APPEALS
FOR THE EIGHTH CIRCUIT

No. 19,000. September Term 1968

University of Illinois Foundation,

Appellant,

vs.

Winegard Company.

APPEAL FROM the United States District Court for the Southern District of Iowa.

THIS CAUSE came on to be heard on the record from the United States District Court for the Southern District of Iowa, and was argued by counsel.

ON CONSIDERATION WHEREOF, it is now here ordered and adjudged by this Court, that the judgment of the said District Court, in this cause, be, and the same is hereby, affirmed.

September 30, 1968.

A TRUE COPY

ATTEST:

Signature illegible
Clerk, U. S. Court of Appeals
For the Eighth Circuit.

UNITED STATES OF AMERICA
SOUTHERN DISTRICT OF IOWA
DAVENPORT DIVISION
} ss.

I, R. E. LONGSTAFF, Clerk of the United States District Court for the Southern District of Iowa, do hereby certify that the annexed and foregoing is a true and full copy of the original Judgment on Decision by the Court, filed June 26, 1967, and Judgment by United States Court of Appeals, filed April 3, 1969, in Civil Action No. 3-695-D, University of Illinois Foundation vs. Winegard Company now remaining among the records of the said Court in my office.

IN TESTIMONY WHEREOF, I have hereunto subscribed my name and affixed the seal of the aforesaid Court at Davenport, Iowa, this 3rd day of August, A.D. 1972.

R. E. LONGSTAFF,
Clerk.

By DIANE DUNCAN,
Deputy Clerk.

IN THE

UNITED STATES COURT OF APPEALS

FOR THE SEVENTH CIRCUIT

SEPTEMBER TERM, 1972 — APRIL SESSION, 1973

Nos. 72-1741, 72-1742, 72-1743, 72-1744 and 72-1745

TECHNOGRAPH PRINTED CIRCUITS, LTD., and TECHNOGRAPH PRINTED ELECTRONICS, INCORPORATED,
Plaintiffs-Appellants, and *Cross-Appellees,*

v.

METHODE ELECTRONICS, INC.,
Defendant-Appellee,

v.

GTE AUTOMATIC ELECTRIC INCORPORATED,
Defendant-Appellee and *Cross-Appellant,*

v.

WEBCOR ELECTRONICS, INCORPORATED,
Defendant-Appellee,

v.

HOWARD HOLDING COMPANY,
Defendant-Appellee.

Appeals from the United States District Court for the Northern District of Illinois, Eastern Division.

Nos. 62 C 1761
63 C 36
63 C 111
63 C 142

HUBERT L. WILL,
Judge.

ARGUED JUNE 11, 1973 — DECIDED AUGUST 27, 1973

Before KILEY and SPRECHER, *Circuit Judges,* and ESCHBACH, *District Judge.**

* District Judge Jesse E. Eschbach of the Northern District of Indiana is sitting by designation.

SPRECHER, *Circuit Judge.* The history of these cases confirms the wisdom of *Blonder-Tongue Laboratories, Inc.* v. *University of Illinois Foundation,* 402 U.S. 313 (1971) and why the doctrine it announced is particularly applicable here.

Between 1958 and 1963, Technograph Printed Circuits, Ltd., and Technograph Printed Electronics, Inc. instituted some 74 civil actions for patent infringement against approximately 80 manufacturers of electronic equipment in 18 different United States District Courts, and another action against the United States in the Court of Claims.[1] Prior to the litigation, the president of Printed Electronics, an American company, wrote to Printed Circuits, a British company:

> "The Technograph patents are inherently weak and at heart only form the legal basis for making a claim against industry. Their real worth in America depends entirely how strongly they can be backed by both money, legal talent and influence.
>
> ". . . We must litigate if we expect to extract worthwhile sums from industry."

• • •

The infringement actions were based upon three United States patents relating to methods for the manufacture of printed electric or magnetic circuits[2] — No. 2,441,960 ('960) issued on May 25, 1948, No. 2,706,697 ('697) issued on April 15, 1955, and Reissue No. 24,165 ('165) issued on June 12, 1956.

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[1] *Technograph Printed Circuits, Ltd.* v. *Methode Electronics, Inc.*, 285 F. Supp. 714, 716 (N.D. Ill. 1968) (detailing the history of the Technograph litigation).

[2] The manufacturing processes are fully described in *Technograph Printed Circuits, Ltd.* v. *Bendix Aviation Corp.*, 218 F. Supp. 1 (D. Md. 1963).

The first trial took place in the District of Maryland in an action against The Bendix Corporation (*Bendix*) where, after 29 trial days, the filing of 1001 exhibits, several additional days spent by the court in visiting the Bendix and plaintiffs licensed plants, 600 pages of post-trial briefs and two days of oral argument, Judge Watkins on May 27, 1963 held in a 67-page opinion that the claims at issue in all three patents were invalid. The Court of Appeals for the Fourth Circuit affirmed and certiorari was denied by the Supreme Court. *Technograph Printed Circuits, Ltd.* v. *Bendix Aviation Corp.*, 218 F. Supp. 1 (D. Md. 1963), *aff'd per curiam*, 327 F.2d 497 (4th Cir. 1964), *cert. denied*, 379 U.S. 826 (1964).

The plaintiffs represented in other courts that the Maryland case was the "test case"[3] After the test case, the British company transferred its rights in the patents to the American Company.

The plaintiffs had filed six infringement actions in the Northern District of Illinois in 1962 and 1963. Two were settled and Judge Igoe granted summary judgment in favor of the remaining four defendants after Judge Watkins' decision on the theory that "one bite of the cherry ought to be enough." We reversed and remanded for further proceedings on the authority of *Aghnides* v. *Holden*, 226 F.2d 949, 950 (7th Cir. 1955), where we cited *Triplett* v. *Lowell*, 297 U.S. 638, 642 (1936) for the proposition that "[n]either reason nor authority supports the contention that an adjudication adverse to any or all the claims of a patent precludes another suit upon the same claims against a different defendant." *Technograph Printed Circuits, Ltd.*

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[3] *Technograph Printed Circuits, Ltd.* v. *Packard Bell Electronics Corp.*, 290 F. Supp. 308, 312 (C.D. Cal. 1968). See also, *Technograph Printed Circuits, Ltd.* v. *Martin-Marietta Corp.*, 474 F. 798, 804 (4th Cir. 1973).

v. *Methode Electronics, Inc.*, 356 F.2d 442, 448 n.3 (7th Cir. 1966), *cert. denied*, 384 U.S. 950, 1002 (1966). Upon remand the four cases were consolidated for purposes of discovery and trial, were declared to be class actions so far as the defendants were concerned (*Technograph Printed Circuits, Ltd.* v. *Methode Electronics, Inc.*, 285 F. Supp. 714 (N.D. Ill. 1968), and the plaintiffs' claims relating to Nos. '960 and '165 were dismissed with prejudice on April 24, 1968, with no appeal being taken therefrom.

In the meantime, all of the files, records, exhibits and transcripts from the *Bendix* case in Maryland had been sent to the United States District Court for the Central District of California, where 13 actions by the Technograph plaintiffs had been consolidated. The defendants in California moved for summary judgment on the ground of estoppel by the Maryland judgment. While the motions were pending, the court granted the defendants' motion to compel the plaintiffs to produce any evidence "above and beyond the evidence they presented" in the Maryland case.[4] The court on August 8, 1968 found that "the Response of plaintiffs . . . together with the unindexed box of documents . . . [filed with the Clerk] was a wilful, intentional, and conscious flouting and disobedience of the Orders of this Court . . . [which] warrant the severest condemnation," whereupon the 13 actions were dismissed with costs in favor of the defendants. *Technograph Printed Circuits, Ltd.* v. *Packard Bell Electronics Corp.*, 290 F. Supp. 308 (C.D. Cal. 1968). There is no published record of an appeal from that judgment.

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[4] The court's order appears as Appendix II, *Technograph Printed Circuits, Ltd.* v. *Packard Bell Electronics Corp.*, 290 F. Supp. 326 (C.D. Cal. 1967).

Meanwhile there also was activity in plaintiffs case in the United States Court of Claims. After the court denied two motions by the government for partial summary judgment.[5] trial was held before Commissioner Davis who found claims 4, 10, 13 and 14 of No. '697 to be invalid on March 2, 1970. *Technograph Printed Circuits, Ltd.* v. *United States,* 164 U.S.P.Q. 584 (1970). We are advised by counsel for the parties here that this decision is under advisement before the Court of Claims together with a government motion urging estoppel based on the *Bendix* case.

On May 3, 1971, the Supreme Court of the United States decided *Blonder-Tongue Laboratories, Inc.* v. *University of Illinois Foundation,* 402 U.S. 313, where the Court concluded that "*Triplett* should be overruled to the extent it forecloses a plea of estoppel by one facing a charge of infringement of a patent that has once been declared invalid." 402 U.S. at 350. The Court added that a plea of estoppel must not be automatically accepted but that a determination should be made "whether a patentee has had a full and fair chance to litigate the validity of his patent in an earlier case. . . ." 402 U.S. at 333. Thereupon, the defendants in four suits (which had been filed in the district court in Maryland, the *Martin-Marietta* case, in addition to the concluded *Bendix* case) moved for dismissal on the ground that *Bendix* constituted collateral estoppel. Judge Watkins, after carefully applying the *Blonder-Tongue* standards for determining whether the plaintiffs had a full and fair trial in *Bendix* and after

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[5] *Technograph Printed Circuits, Ltd.* v. *United States,* 370 F.2d 571 (Ct. Cl. 1966) and 372 F.2d 969 (Ct. Cl. 1967). In the latter case, the Court of Claims relied upon *Triplett* v. *Lowell,* 297 U.S. 638 (1936) and the possibility of new or additional evidence, 372 F.2d at 978-80.

evaluating plaintiffs' contentions as to why they did not, including virtually all the contentions urged before us in the present case, sustained the pleas of estoppel and dismissed the cases on March 20, 1972. *Technograph Printed Circuits, Ltd.* v. *Martin-Marietta Corp.*, 340 F. Supp. 423 (D. Md. 1972).

On May 31, 1972, Judge Will, who had by that time fully tried the four Chicago consolidated cases[6] agreed with Judge Watkins that the *Bendix* case presented the plaintiffs with a full and fair opportunity to establish the validity of their patents and that it was "just and equitable to allow the plea of estoppel," thus dismissing the consolidated cases before him. *Technograph Printed Circuits, Ltd.* v. *Methode Electronics, Inc.*, 174 U.S.P.Q. 297 (N.D. Ill. 1972).

Thereafter on February 20, 1973, the Court of Appeals for the Fourth Circuit affirmed Judge Watkins in *Technograph Printed Circuits, Ltd.* v. *Martin-Marietta Corp.*, 474 F.2d 798 (4th Cir. 1973). Judge Widener in a detailed and exhaustive consideration of the application of *Blonder-Tongue* to *Bendix* in view of Plaintiffs' multiple contentions against its application, concluded at page 811:

> "Here, the same plaintiffs considered *Bendix* a test case by which they sought to establish the validity of Eisler's patents '165, '960, and '697. They now seek to relitigate the issue of validity as to '697. They failed to convince the district court in *Bendix* of its validity, and they failed on appeal to convince us that the district court was wrong in the instant cases. Plaintiffs have failed to convince the same district judge who decided

[6] The record brought up to us from Judge Will included 17 volumes of pleadings, 42 volumes of transcript, a great number of depositions, 4 cartons plus 8 folders of exhibits, and a box of "confidential documents."

> *Bendix* that they did not have a full and fair opportunity to litigate in *Bendix*. Again, we agree with the district court. We are of opinion that the plaintiffs had a full and fair opportunity to litigate the validity of '697 in *Bendix* and that it is just and equitable to allow defendants' pleas of estoppel. We believe the instant cases show precisely why the Supreme Court, in *Blonder-Tongue*, overruled *Triplett* and commenced the sustaining of pleas of estoppel by judgment in certain patent cases."

We agree with Judge Widener and the Fourth Circuit, which considered virtually the same contentions made here by the plaintiffs for the non-application of *Blonder-Tongue*. We also agree with Judge Will who had the opportunity to hear all of plaintiffs' evidence and to evaluate it in the light of the *Blonder-Tongue* standards for determining whether *Bendix* was in fact a full and fair trial.

Subsequent to oral argument, plaintiffs urged by letter that we consider our recent decision in *Bourns, Inc.* v. *Allen-Bradley Co.*, Nos. 72-1222 and 72-1223 (June 14, 1973), where in an opinion by Mr. Justice Clark, sitting in the Seventh Circuit by designation, we held that *Blonder-Tongue* does not apply to claims not litigated in the prior case. Plaintiffs have argued that *Bendix* adjudicated the invalidity of method claims 4, 5, 10, 14, 15 and 16 of '697 and that in the present cases claims 11, 12 and 13 are also involved. However, prior to the trial before Judge Will, the parties agreed to finding of fact No. 23 which reads:

> "Claims 11, 12 and 13 are basically the same as claim 10 except for the specific means of printing; they are contingent upon claim 10 and will either stand or fall with claim 10."

Even without the stipulation, a reading of claims 10, 11, 12 and 13 demonstrates the complete dependence of 11, 12 and 13 upon claim 10.[7]

Furthermore, the same contention was made in the Fourth Circuit proceeding where the District Court found plaintiffs had there conceded that, although the *Martin-Marietta* case involved claims 4 and 10-14 and *Bendix* involved 4, 5, 10, 14, 15 and 16, the issues in both cases were "identical". 340 F. Supp. at 425. That fact was not contested on appeal. 474 F.2d at 802.

Under all of these circumstances the invalidity of claims 11, 12 and 13 were established by *Bendix*.

Defendant GTE Automatic Electric Inc. has cross-appealed from the trial court's refusal to award it costs and attorney fees. In this circuit, attorney fees are only awarded under 35 U.S.C. §285 in exceptional cases "to prevent gross injustice and where fraud and wrong-doing are clearly proved." *Sarkes Tarizan Inc.* v. *Philco Corp.*, 351 F.2d 557, 560 (7th Cir. 1965).

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[7] "10. A method of manufacturing a component of electric and magnetic circuit systems involving an insulation backed conductive pathway pattern, which comprises providing insulation backed foil, then printing a negative representation of the pattern upon said foil, depositing a layer of metal dissimilar to the metal of said foil upon all exposed parts of said foil, then removing said representation from the foil, and finally removing all parts of the foil exposed by said removal of the representation by chemical action attacking the metal of said foil but not said deposited dissimilar metal whereby said pathway pattern is formed.

"11. The method of claim 10 wherein the negative representation of the pattern is produced by letterpress printing.

"12. The method of claim 10 wherein the negative representation of the pattern is produced by offset printing.

"13. The method of claim 10 wherein the negative representation of the pattern is produced by photo-mechanical means."

Although the defendants rely upon a 1951 statement by Eisler, the inventor of '960, '165 and '697, that "we have fooled the Patent Office" and the 1956 statement by the president of one of the plaintiffs that the patents were "inherently weak," we note in Judge Will's opinion that the defendants "were apparently content to go on litigating indefinitely over the validity of a patent no matter how frequently it had been found invalid." 174 U.S.P.Q. at 299. In addition, until the *Blonder-Tongue* decision, the plaintiffs were justified in relying at least to some extent upon *Triplett* v. *Lowell.* Thus we find that Judge Will did not abuse his discretion in declining to find this to be the "exceptional" case. We do, however, assess all costs of these appeals against the plaintiffs.

The judgment is affirmed in all respects.

AFFIRMED.

CONSTITUTION

ARTICLE I

Section 8, Clause 8. The Congress shall have Power . . .

To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries;

28 U.S.C. § 1254.

Cases in the courts of appeals may be reviewed by the Supreme Court by the following methods:

(1) By writ of certiorari granted upon the petition of any party to any civil or criminal case, before or after rendition of judgment or decree . . .

35 U.S.C. § 101.

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

35 U.S.C. 121. If two or more independent and distinct inventions are claimed in one application, the Commissioner may require the application to be restricted to one of the inventions. If the other invention is made the subject of a divisional application which complies with the requirements of section 120 of this title it shall be entitled to the benefit of the filing date of the original application. A patent issuing on an application with respect to which a requirement for restriction under this section has been made, or on an application filed as a result of such a requirement, shall not

be used as a reference either in the Patent Office or in the courts against a divisional application or against the original application or any patent issued on either of them, if the divisional application is filed before the issuance of the patent on the other application. If a divisional application is directed solely to subject matter described and claimed in the original application as filed, the Commissioner may dispense with signing and execution by the inventor. The validity of a patent shall not be questioned for failure of the Commissioner to require the application to be restricted to one invention.

35 U.S.C. § 253.

Whenever, without any deceptive intention, a claim of a patent is invalid the remaining claims shall not thereby be rendered invalid. A patentee, whether of the whole or any sectional interest therein, may, on payment of the fee required by law, make disclaimer of any complete claim, stating therein the extent of his interest in such patent. Such disclaimer shall be in writing, and recorded in the Patent Office; and it shall thereafter be considered as part of the original patent to the extent of the interest possessed by the disclaimant and by those claiming under him.

In like manner any patentee or applicant may disclaim or dedicate to the public the entire term, or any terminal part of the term, of the patent granted or to be granted.

35 U.S.C. § 282, par 1.

A patent shall be presumed valid. Each claim of a patent (whether in independent or dependent form) shall be presumed valid independently of the validity of other claims; dependent claims shall be presumed valid even though dependent upon an invalid claim. The burden of establishing invalidity of a patent or any claim thereof shall rest on the party asserting it.

35 U.S.C. § 288.

Whenever, without deceptive intention, a claim of a patent is invalid, an action may be maintained for the infringement of a claim of the patent which may be valid. The patentee shall recover no costs unless a disclaimer of the invalid claim has been entered at the Patent Office before the commencement of the suit.

RULES OF PRACTICE IN PATENT CASES

141. **Different inventions in one application.** Two or more independent and distinct inventions may not be claimed in one application, except that more than one species of an invention, not to exceed five, may be specifically claimed in different claims in one application, provided the application also includes an allowable claim generic to all the claimed species and all the claims to each species in excess of one are written in dependent form (rule 75) or otherwise include all the limitations of the generic claim.

142. **Requirement for restriction.** (a) If two or more independent and distinct inventions are claimed in a single application, the examiner in his action shall require the applicant in his response to that action to elect that invention to which his claims shall be restricted, this official action being called a requirement for restriction (also known as a requirement for division). If the distinctness and independence of the inventions be clear, such requirement will be made before any action on the merits; however, it may be made at any time before final action in the case, at the discretion of the examiner.

(b) Claims to the invention or inventions not elected, if not canceled, are nevertheless withdrawn from further consideration by the examiner by the election, subject however to reinstatement in the event the requirement for restriction is withdrawn or overruled.

MANUAL OF PATENT EXAMINING PROCEDURE

(3rd ed. rev. April 1973)

706.03(1) Multiplicity

An unreasonable number of claims; that is unreasonable in view of the nature and scope of applicant's invention and the state of the art, may afford a basis for a rejection on the ground of *multiplicity*. A rejection on this ground should include all the claims in the case inasmuch as it relates to confusion of the issue.

To avoid the possibility that an application which has been rejected on the ground of undue multiplicity of claims may be appealed to the Board of Appeals prior to an examination on the merits of at least some of the claims presented, the examiner should, at the time of making the rejection on the ground of multiplicity of claims, specify the number of claims which in his judgment is sufficient to properly define applicant's invention and require the applicant to select certain claims, not to exceed the number specified, for examination on the merits. The examiner should be reasonable in setting the number to afford the applicant some latitude in claiming his invention.

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IN THE

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OCTOBER TERM 1973

ALLEN-BRADLEY COMPANY,
BECKMAN INSTRUMENTS, INC.,
THE BUNKER-RAMO CORPORATION,
FAIRCHILD CAMERA & INSTRUMENT CORP.,
TRW INC., and
WESTON INSTRUMENTS, INC.,
Petitioners

v.

BOURNS, INC. and MARLAN E. BOURNS,
Respondents

RESPONSE TO PETITION FOR A WRIT OF CERTIORARI TO THE SEVENTH CIRCUIT FILED BY BECKMAN INSTRUMENTS, INC.

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OCTOBER TERM 1973

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RESPONSE TO PETITION FOR A WRIT OF CERTIORARI TO THE SEVENTH CIRCUIT FILED BY BECKMAN INSTRUMENTS, INC.

Respondents, Bourns, Inc. and Marlan E. Bourns (collectively Bourns),[1] oppose the petition of Beckman Instruments, Inc. (Beckman) as follows:

1) Beckman's arguments as to the interpretation of a judgment and a decision evidences a factual dispute of interest only to the litigants. This factual dispute does not meet any of the criteria set forth in Supreme Court Rule 19.

[1] The parties have filed cross-petitions; Bourns' petition has been assigned docket No. 73-643.

2) Beckman's arguments as to the legal relationship as between claims of a patent are contrary to the patent laws (35 U.S.C. §§ 253, 282 and 288).

3) Contrary to Beckman's arguments there is no conflict between the circuits on whether an adjudication of invalidity as to less than all the claims of a patent would in subsequent litigaton support a plea of estoppel as to all of the clams of that patent.

Interpretation of the Dale Judgment

In the *Dale* case[2] the District Court entered the following judgment:

> "2. Claims 1, 2, 11, 14, 15, 16 and 20 of the United States Patent No. 2,777,926 are invalid."
>
> "7. The Amended Complaint is dismissed with prejudice, and the Amended Counterclaim is sustained to the extent indicated."

In its decision the *Dale* Court began: "Plaintiff relies upon claims 1, 2, 11, 14, 15, 16 and 20 of the '926 patent."

Through an eclectic selection of statements from the *Dale* decision Beckman attempts to show that the Court of Appeals here erred in limiting the scope of the *Dale* judgment to the precise terms thereof. The thrust of Beckman's argument is that the judgment did not mean what it said. Beckman's arguments make it clear it wants this Court to resolve a factual dispute between the parties.

Relationship between Patent Claims

Beckman argues that each patent covers only one invention, and the claims of a patent must always stand or fall together. This would mean, of course, that the statutory

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[2] *Bourns, Inc.* v. *Dale Elec., Inc.*, 308 F.Supp. 501 (D. Neb. 1969)

program outlined in 35 U.S.C. 253, 282 and 288 is a nullity. It would mean that the scores of decisions[3] which held some claims of a patent valid and some invalid have been wrong.

Section 282 of Title 35 states,

> "Each claim of a patent (whether in independent or dependent form) shall be presumed valid independently of the validity of other claims . . ."

Beckman's argument is simply contrary to the Congressional mandate.

Beckman's argument that the Court of Appeals decision reduces the effect of *Blonder-Tongue*[4] from a "knock-out blow"[5] to a "gentle jab" at the multiplicity of patent litigation reflects a serious misunderstanding of the underlying premises of that decision. *Blonder-Tongue* rests on the critical premise of a full and fair hearing. Absent such a hearing *Blonder-Tongue* itself recognizes that estoppel will not lie even though a claim or claims have been previously adjudicated as invalid. Obviously patent claims not at issue have not been provided the requisite full and fair hearing.

The Court in *Blumcraft,* supra, qualified its "knockout blow" with the condition that there had been a "fair fight". In this case, as to the claims not at issue in the *Dale* case, supra, there was no fight, let alone a fair one.

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[3] See, e.g., *Ansul Co.* v. *Uniroyal, Inc.*, 448 F.2d 872 (2d Cir. 1971); *Garrett Corp.* v. *United States*, 422 F.2d 874 (Ct. Cl. 1970); *McCutchen* v. *Singer Co.*, 386 F.2d 82 (5th Cir. 1968); *Hensley Equip. Co.* v. *Esco Corp.*, 375 F.2d 432 (9th Cir. 1967); *Zegers* v. *Zegers, Inc.*, 365 F.2d 156 (7th Cir. 1966); *Ballantyne Inst. & Elec., Inc.* v. *Wagner*, 345 F.2d 671 (6th Cir. 1965).

[4] *Blonder-Tongue Labs, Inc.* v. *University of Illinois Found.*, 402 U.S. 313 (1971).

[5] Terminology taken from *Blumcraft of Pittsburgh* v. *Kawneer*, 178 USPQ 513 (5th Cir. 1973).

Conflict Between The Circuits

Beckman argues that the decision as to the unadjudicated claims is in conflict with decision in the Fourth,[6] Seventh,[7] and Tenth[8] Circuits, and the Central District of California.[9] Each of those decisions is clearly distinguishable on the facts. In the *Technograph* decisions rendered by the Fourth and Seventh Circuits, both Courts relied on the fact that even though there were at issue three claims not asserted in the earlier case,[10] the plaintiff had stipulated that no new issues were being raised. Moreover, in the earlier case Technograph asserted that that proceeding was its test case. It was on these grounds that the Seventh Circuit distinguished its decision in *Technograph* from its holding in this case.

In the *Blonder-Tongue* decision, on remand from this Court, Judge Hoffman precisely pointed out that the Court of Appeals for the Eighth Circuit had adjudged the entire patent invalid (334 F.Supp. at 51).

In the *Blumcraft* decision the District Court likewise precisely pointed out (337 F.Supp. at 859) that in the earlier South Carolina case

> "both in the trial and appellate courts, the final judgments referred to the validity and invalidity of the

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[6] *Technograph Printed Circuits, Ltd.* v. *Martin-Marietta Corp.*, 474 F.2d 798 (4th Cir. 1973).

[7] *Univ. of Illinois Foundation* v. *Blonder-Tongue Labs., Inc.*, 465 F.2d 380 (1972), affirming, 334 F.Supp. 47 (N.D. Ill. 1971); *Technograph Printed Circuits, Ltd.* v. *Methode Electronics Inc.* ... F.2d ..., 179 USPQ 206 (7th Cir. 1973), affirming, 174 USPQ 297 (N.D. Ill. 1972).

[8] *Blumcraft of Pittsburgh* v. *Architectural Art. Mfg., Inc.*, 337 F.Supp. 853 (D. Kan. 1972), aff'd per curiam, 459 F.2d 482 (10th Cir. 1972).

[9] *Technograph Printed Circuits, Ltd.* v. *Packard Bell Electronics Corp.*, 290 F.Supp. 308 (C.D. Cal. 1968).

[10] *Technograph Printed Circuits, Ltd.* v. *Bendix Aviation Corp.*, 218 F.Supp. 1 (D. Md. 1963), aff'd, 327 F.2d 497 (4th Cir. 1964).

> whole patent . . . . No separability or savings clause as to any claims is indicated by the Fourth Circuit."

It is manifestly clear that the facts on which Blumcraft turned materially differ from the judgment in the *Dale* case.

The thrust of Beckman's petition is an attempt to expand the doctrine of collateral estoppel to the limits of the doctrine of res judicata. Justice Clark in his opinion obviously recognized the distinction and rejected the attempt.

CONCLUSION

Beckman is unable to show that any of the criteria of Supreme Court Rule 19 are present here. For that reason Beckman's petition should be denied.

Respectfully submitted,

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